

3731

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Total Number of Pages in This Submission

Application Number	08/461,402
Filing Date	06/05/1995
First Named Inventor	Andrew Cragg
Art Unit	3731
Examiner Name	Michael H. Thaler
Attorney Docket No.	BSI-F140US

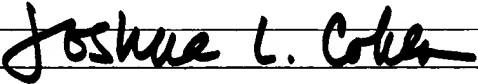
ENCLOSURES (Check all that apply)

- Fee Transmittal Form
 - Fee Attached
- Amendment/Reply
 - After Final
 - Affidavits/Declaration(s)
- Extension of Time Request
- Express Abandonment Request
- Information Disclosure Statement
- Certified Copy of Priority Document(s)
- Response to Missing Parts/
Incomplete Application
 - Response to Missing Parts
under 37 CFR 1.52 or 1.53

- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation, Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s) _____
 - Landscape Table on CD

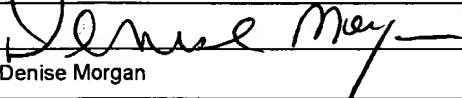
- After Allowance Communication to TC
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter
- Other Enclosure(s) (please identify below): 5 pg.
Communication; 3/10/99
Judgment, Interference No.
104,083; 7/21/2001 Final
Decision and Judgment,
Interference No. 104,192;
3/31/06 Memorandum Opinion
and Final Judgment, U.S.
District Court; 8/8/07 Opinion,
U.S. Court of Appeals for the
Federal Circuit; Paper No. 16,
including exhibits 1-4,
Interference No. 104,083; Paper
No. 20, Interference No.
104,083; post card receipt

Remarks:**SIGNATURE OF APPLICANT, ATTORNEY OR AGENT**

Firm Name	RatnerPrestia		
Signature			
Printed Name	Joshua L. Cohen		
Date	10/16/08	Registration No.	38,040

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appn. No: 08/461,402
Applicant: Andrew H. Cragg et al.
Filed: 06/05/1995
Title: BIFURCATED ENDOLUMINAL PROSTHESIS
TC/A.U.: 3731
Examiner: Michael H. Thaler
Confirmation No.: 6448
Docket No.: BSI-140US

COMMUNICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This application was involved in Interference No. 104,083 and Interference No. 104,192. *Ex parte* prosecution of this application was suspended because of the Interferences.

Interference No. 104,083

A copy of the Board's March 10, 1999 Judgment in Interference No. 104,083 is attached for the Examiner's convenience. In the Judgment, the Board entered the following two orders, among others:

It is ORDERED that on this record, Andrew H. Cragg and Michael D. Dake are entitled to a patent containing their application claim 89 which corresponds to the count.

It is ORDERED that upon return of party Cragg's involved application to the primary examiner, party Cragg shall inform the examiner of the administrative patent judge's decision (Paper No. 20) granting party Cragg's motion to correct inventorship (Paper No. 16), and request that the correction, inclusive of the accompanying petition and amendment, be processed and entered in the official file of party Cragg's involved application.

Accordingly, Applicants hereby inform the Examiner of Paper Nos. 16 and 20 (copies attached) in Interference No. 104,083 and request that the Examiner implement the Board's orders.

Interference No. 104,192

Copies of the following decisions regarding Interference No. 104,192 are also attached for the Examiner's convenience:

- July 21, 2001 Final Decision and Judgment ("Final Decision");
- March 31, 2006 Memorandum Opinion and Final Judgment of the U.S. District Court for the District of Columbia in *Scimed Life Systems, Inc. v. Medtronic Vascular, Inc.*, Civil Case No. 01-2015 (RJL) ("Scimed Life Systems"); and
- August 8, 2007 Opinion of the U.S. Court of Appeals for the Federal Circuit in *Boston Scientific Scimed, Inc. v. Medtronic Vascular, Inc.*, No. 2006-1434 ("Boston Scientific Scimed").

In the July 21, 2001 Final Decision, the Board granted Motion 12 of party Fogarty, which had requested the Board

to deny the senior party [Cragg and Dake] the benefit of EP94400284.9 and EP94401306.9 on grounds that neither application was filed by (i) the individual now identified as the inventor or (ii) on his behalf by his legal representatives or assigns. (Final Decision at p. 2)

The Board also entered the following Order, among others:

It is . . . FURTHER ORDERED that junior party ANDREW H. CRAGG and MICHAEL D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and 90 which correspond to the count. (Final Decision at p. 69)

In the District Court proceeding, the stipulated issue to be resolved was:

Whether the Board erroneously affirmed its Grant of Fogarty *et al.* (Medtronic) Motion 12 in its July 27, 2001 Final Decision denying Cragg *et al.* (Scimed) benefit of the February 9, 1994 filing date of its European application No. 94400284.9 as a date of invention for the subject matter of the single count in Interference No. 104,192. (*Scimed Life Systems*, slip op. at p. 7.)

The District Court found that

the Board did not err in its granting of party Fogarty's (Medtronic's) motion No. 12 which denied Cragg *et al.* (Scimed) the benefit of the earlier filing date of

European application No. 94400284.9 and affirms the Board's award of priority to Fogarty *et al.* (Medtronic) in its July 27, 2001 Final Decision and Judgment. (*Scimed Life Systems*, slip op. at p. 14.)

In the August 8, 2007 Opinion, the Federal Circuit affirmed the decision of the U.S. District Court for the District of Columbia. *Boston Scientific Scimed*, slip op. at 7.

Applicants will not seek further appellate review of Interference No. 104,192.

Ex Parte Prosecution of this Application

It appears that this application is ready for return to *ex parte* prosecution. 37 C.F.R. § 41.127(c) provides:

The judgment may include a recommendation for further action by the examiner or by the Director.

MPEP § 2308 states:

Jurisdiction over an application returns to the examiner once the interference has terminated. If there is a recommendation for further action in the application, the examiner must reopen prosecution to consider the recommendation.

Action Regarding Petition to Correct Inventorship

Applicants attach a copy of Goicoechea et al. Motion To Correct Inventorship (Paper No. 16) that was filed in Interference No. 104,083, including the four exhibits attached to the motion, listed here (Exhibit numbers are shown in the lower right hand corner of the first page of each exhibit):

- Petition For Correction Of Inventorship Pursuant to 37 C.F.R. § 1.48(b) (Exhibit 1 to Paper No. 16);
- Amendment of Inventorship Pursuant To 37 C.F.R. § 1.48(b) (Exhibit 2 to Paper No. 16)

- Claims Pending in U.S. Patent Application No. 08/461,402, filed June 5, 1995, as of January 22, 1997 (Exhibit 3 to Paper No. 16); and
- Claims pending in U.S. Application No. 08/461,402, filed June 5, 1995, as of August 14, 1998 (Exhibit 4 to Paper No. 16).

Applicants also attach a copy of the Decision on Motions of the Administrative Patent Judge dated January 7, 1999 (Paper No. 20 that was filed in Interference No. 104,083).

Pursuant to the Board's Judgment, Applicants request that these papers be processed and entered into the official file of the present application.

Information Disclosure Statements And Other Papers Filed While This Application Was In Suspense

While this application was in suspense, Applicants filed the following Information Disclosure Statements and other papers:

- Amendment filed November 4, 1998;
- Supplemental Information Disclosure Statement filed March 12, 1999;
- Supplemental Information Disclosure Statement filed April 26, 2001;
- Response to Office Action filed May 16, 2003;
- Supplemental Information Disclosure Statement filed August 18, 2004;
- Change of correspondence address filed December 9, 2005;
- Response filed June 8, 2006 to the Office Communication dated April 21, 2006; and
- Communication regarding suspension of prosecution filed January 3, 2007.

Applicants request that the PTO enter and consider all Information Disclosure Statements and other papers as appropriate.

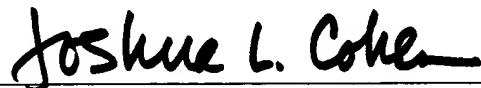
Supplemental Information Disclosure Statement And Amendment Filed Concurrently With This Communication

Concurrently with the filing of the present Communication, Applicants are filing an Amendment to the claims and a Supplemental Information Disclosure Statement. Applicants request that the PTO consider both of these additional filings concurrently with its consideration of the present Communication.

Conclusion

For all of the above reasons, Applicants request confirmation that their petition to correct inventorship has been entered, confirmation that all Information Disclosure Statements (including the concurrently filed Supplemental Information Disclosure Statement) and other papers have been entered and considered. Applicants also request the return of this application to *ex parte* prosecution and the examination of the claims now pending in this application, including the claims added by the concurrently filed Amendment.

Respectfully submitted,



Joshua L. Cohen, Reg. No. 38,040
Stanley Weinberg, Reg. No. 25,276
Attorneys for Applicants

JLC/SW/dhm

Enclosures: March 10, 1999 Judgment, Interference No. 104,083
July 21, 2001 Final Decision and Judgment, Interference No. 104,192
March 31, 2006 Memorandum Opinion and Final Judgment, U.S. District Court
August 8, 2007 Opinion, U.S. Court of Appeals for the Federal Circuit
Paper No. 16, including Exhibits 1-4, Interference No. 104,083
Paper No. 20, Interference No. 104,083

Dated: October 16, 2008

P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Director is hereby authorized to charge or credit Deposit Account No.
18-0350 for any additional fees, or any underpayment or credit for
overpayment in connection herewith.

**March 10, 1999 Judgment
Interference No. 104,083**

RECEIVED

BSI-944

MAR 12 1999

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

RATNER & PRESTIA

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 10 1999

ERIC C. MARTIN,
Junior Party
(Patent No. 5,575,817)¹,

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

ANDREW H. CRAGG, and MICHAEL D. DAKE

Senior Party
(Application 08/461,402)²

Patent Interference No. 104,083

Before McKelvey, Senior Administrative Patent Judge, Schafer, Lee and Torczon, Administrative patent Judges.

PER CURIAM

JUDGMENT

Junior party Martin has failed to serve its case-in-chief testimony on priority by the time such service was due, i.e.,

¹ Filed August 19, 1994.

² Assigned to Boston Scientific Technology, Inc. Accorded the benefit of European applications EP9440284.9, filed February 9, 1994, and EP94401306.9, filed June 10, 1994. Also accorded the benefit of U.S. applications 08/317,763, filed October 4, 1994, and 08/312,881, filed September 27, 1994.

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Interference No. 104,083
Martin v. Cragg

March 1, 1999. Based on party Martin's failure to take testimony, party Cragg has filed a miscellaneous motion for judgment or a show cause order under 37 CFR § 1.652.

In a telephone conference conducted at 2:45 PM, March 8, 1999, between administrative patent judge Jameson Lee and counsel to the respective parties, Mr. Peter Davis, counsel to party Martin, indicated that the failure to serve its case-in-chief evidence was not inadvertent and that the junior party would have no objection to the Board's entering adverse judgment against party Martin on the basis that its case-in-chief evidence was not served. Accordingly, entry of judgment against party Martin is now appropriate.

It is **ORDERED** that judgment as to the subject matter of count 1 is entered against junior party Martin and awarded in favor of senior party Cragg.

It is **ORDERED** that Eric C. Martin is not entitled to a patent containing claim 1 of his involved patent, which corresponds to count 1.

It is **ORDERED** that on this record, Andrew H. Cragg and Michael D. Dake are entitled to a patent containing their application claim 89 which corresponds to the count.

It is **ORDERED** that upon return of party Cragg's involved application to the primary examiner, party Cragg shall inform the

Interference No. 104,083
Martin v. Cragg

examiner of the administrative patent judge's decision (Paper No. 20) granting party Cragg's motion to correct inventorship (Paper No. 16), and request that the correction, inclusive of the accompanying petition and amendment, be processed and entered in the official file of party Cragg's involved application.

It is **FURTHER ORDERED** that in light of this entry of judgment, party Cragg's motion for judgment or an order to show cause why judgment should not be entered against party Martin is dismissed as moot.

Fred Mckelvey
Fred E. Mckelvey, Senior)
Administrative Patent Judge)

Richard E. Schafer
Richard E. Schafer)
Administrative Patent Judge)

Jameson Lee
Jameson Lee)
Administrative Patent Judge)

Richard Torczon
Richard Torczon)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Interference No. 104,083

Martin v. Cragg

Paul F. Prestia
Ratner & Prestia
Suite 301
One Westlakes (Berwyn)
P.O. Box 980
Valley Forge, Pennsylvania 19482-0980

Robert J. Koch
Fulbright & Jaworski
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

**July 27, 2001 Final Decision and Judgment
Interference No. 104,192**

The opinion in support of the decision being entered
today is not binding precedent of the Board.

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Paper No. 187

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ANDREW H. CRAGG and MICHAEL D. DAKE,

Junior Party,
(Application 08/461,402),¹

MAILED

v.

JUL 27 2001

ERIC C. MARTIN,

Junior Party,
(Application 5,575,817),²

PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

THOMAS J. FOGARTY, JAY A. LENKER,
TIMOTHY J. RYAN and KIRSTEN FREISLINGER,

Senior Party,
(Application 08/463,836).³

Patent Interference No. 104,192

¹ Filed 06/05/95. Accorded the benefit of application 08/317,763, filed October 4, 1994, now Patent No. 5,609,627, and application 08/312,881, filed September 27, 1994. The real party in interest is Boston Scientific Technology, Inc.

² Based on application 08/293,541, filed August 19, 1994.

³ Filed June 5, 1995. Accorded the benefit of application 08/255,681, filed June 8, 1994. The real party in interest is Medtronic Aneurx, Inc.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Before MCKELVEY, Senior Administrative Patent Judge, and SCHAFER,
LEE and MEDLEY, Administrative Patent Judges.
LEE, Administrative Patent Judge.

FINAL DECISION AND JUDGMENT

Introduction

When this interference was declared on April 23, 1998, current junior party Cragg was then senior party Goicoechea. Because of the granting of a motion to correct inventorship in related Interference No. 104,083 for application 08/461,402, the same application that is involved in this interference, co-inventors George Goicoechea, John Hudson, and Claude Mialhe were deleted and the only remaining inventors in that application are Andrew H. Cragg and Michael D. Dake. Thus, party Goicoechea became party Cragg. Any reference to party Goicoechea should be understood as a reference to party Cragg.

A decision on the parties' preliminary motions was rendered on February 11, 2000 (Paper No. 108), after which party Fogarty filed a miscellaneous motion (Paper No. 112) for leave to file, out of time, a preliminary motion 12 to attack the benefit accorded party Cragg of European Applications EP94400284.9 and EP94401306.9. The motion for leave as well as the preliminary motion 12 (Paper No. 113) were granted by a panel consisting of administrative patent judges Schafer and Lee (Paper No. 130).

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The decision on Fogarty's preliminary motion 12 was adhered to on reconsideration (Paper No. 138) by a panel consisting of Senior Administrative Patent Judge McKelvey, and Administrative Patent Judges Schafer and Lee. This interference was re-declared in Paper No. 131 to change the junior/senior status of parties Cragg and Fogarty, with Cragg now being junior party.

Junior party Martin did not file a preliminary statement. It has indicated to the administrative patent judge to which this case was assigned that it did not want to participate in this interference except to "ride along" for the possibility that (1) the only interference-in-fact is determined to be between parties Cragg and Martin (a Cragg contention); and (2) that party Cragg will be deprived of its accorded benefit date (a Fogarty contention) and cannot demonstrate a sufficiently early date to prevail over Martin.

Because junior party Cragg filed no case-in-chief during the priority phase of this proceeding, it was placed under an order to show cause why judgment should not be entered against Cragg. Party Cragg requested final hearing for review of the Board's decision on Cragg's preliminary motions 1 and 2 and on Fogarty's preliminary motion 12. According to party Cragg it should not have been made a junior party and thus need not have had to put on a priority case in the first instance. Party Fogarty

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Cragg v. Martin v. Fogarty

requested review of the Board's decision on its preliminary motions 8 and 10. Oral argument was made on February 28, 2001, before administrative patent judges Schafer, Lee and Medley.

Findings of Fact

The below-listed findings as well as those contained in the discussion portion of this opinion are supported by a preponderance of the evidence:

1. This interference was declared on April 23, 1998, between three parties, Martin, Fogarty, and Goicoechea (now Cragg).
2. The involved patent of Martin is Patent No. 5,975,817, based on application 08/293,541, filed August 19, 1994.
3. The involved application of Cragg is application 08/461,402, filed June 5, 1995.
4. The involved application of Fogarty is application 08/463,836, filed June 5, 1995.
5. At the time of declaration of this interference, the named inventors of Cragg's involved application 08/461,402 were George Goicoechea, John Hudson, Claude Mialhe, Andrew H. Cragg, and Michael D. Dake.
6. Cragg's application 08/461,402, was also involved in a related interference, Interference No. 104,083, between parties Cragg and Martin but not Fogarty, wherein a motion to correct

Interference No. 104,192
Cragg v. Martin v. Fogarty

inventorship was granted, deleting George Goicoechea, John Hudson, and Claude Mialhe as co-inventors, and leaving only Andrew H. Cragg and Michael D. Dake.

7. This interference was re-declared on June 2, 1999 (Paper No. 106) to reflect that only Andrew H. Cragg and Michael D. Dake are named inventors in Cragg's involved application.

8. Independent claim 1 of Martin's involved patent reads identically as the count in related Interference No. 104,083, and judgment was entered against party Martin in that interference on March 10, 1999.

9. Claim 2 of Martin's involved patent depends from claim 1, and if re-written in independent form it would read the same as the count in this interference.

10. The count of this interference reads as follows (Paper No. 16):

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

Interference No. 104,192
Cragg v. Martin v. Fogarty

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

11. Cragg's preliminary statement identifies only Michael D. Dake as the inventor of the subject matter of the count.
12. After the rendering of the Board's decision on preliminary motions (Paper No. 108) and subsequent service of the preliminary statement of party Cragg, Cragg filed a miscellaneous motion to amend or correct its preliminary statement to identify Andrew H. Cragg and Michael D. Dake as co-inventors of the subject matter of the count. (Paper No. 117).
13. Cragg's motion to amend was denied. (Paper No. 130). A written opinion explaining the basis of that denial followed. (Paper No. 140). Cragg requested reconsideration. The original decision was adhered to on reconsideration. (Paper No. 146).
14. Cragg has not sought review of the Board's denial of Cragg's motion to amend or correct its preliminary statement to name both Andrew H. Cragg and Michael D. Dake as inventors.

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Cragg v. Martin v. Fogarty

15. Upon declaration of this interference, Cragg was accorded benefit of U.S. application 08/317,763, filed October 4, 1994, European application EP94400284.9, filed February 9, 1994, and European application EP94401306.9, filed June 10, 1994. The European applications did not identify any inventor and were filed by the entity MINTEC SARL.

16. Based on representations from individuals associated with party Cragg, party Fogarty regarded as true, until the service of party Cragg's preliminary statement, that European applications EP94400284.9 and EP94401306.9 were filed by MINTEC SARL on behalf of inventors Goicoechea, Hudson, Mialhe, and Cragg. (Fogarty Preliminary Motion 12, Fact No. 5 - not disputed by Cragg).

17. Michael D. Dake made an assignment of rights, including his interests in the invention covered by Cragg's involved application relating to a bifurcated stent-graft, to MinTec, Inc., for a one time payment of eight hundred thousand U.S. dollars (U.S. \$800,000) and other considerations, on May 6, 1996, with a stated effective date of April 30, 1996. (Cragg Exhibit 1025, CE-1025). The date of assignment was nearly two years and three months from the date of filing of EP94400284.9 on February 9, 1994, and nearly two years from the date of filing of EP94401306.9 on June 10, 1994.

18. Parties Cragg and Fogarty evidently treat, without dispute, that MinTec, Inc. and MINTEC SARL are related entities such that an assignment of interest to the former means the latter is an "assign."

19. Andrew H. Cragg made an assignment of rights, including his interests in the invention covered by Cragg's involved application relating to a bifurcated endoluminal prosthesis, to MINTEC, INC. on August 22, 1994. (Cragg Exhibit 1021, CE-1021). The date of assignment was six months after the date of filing of EP94400284.9 on February 9, 1994, and two months after the date of filing of EP94401306.9 on June 10, 1994.

Discussion

A. Fogarty's Preliminary Motion 12

In the "Relief Requested" portion of Fogarty's preliminary motion 12, it is stated:

Fogarty moves under 37 CFR § 1.633(g) to deny the senior party the benefit of EP94400284.9 and EP94401306.9 on the grounds that neither application was filed by (i) the individual now identified as the inventor or (ii) on his behalf by his legal representatives or assigns.

The statutory basis of Fogarty's preliminary motion 12 is 35 U.S.C. § 119, which states, in pertinent part:

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; (Emphasis added.)

As the motion panel's decision on reconsideration (Paper No. 138) states on page 3, a statement with which we agree and adopt herein:

We interpret the above-quoted "any person who has, or whose legal representatives or assigns have" language as meaning that the previously filed foreign application must have been filed by the person or one who was, at the time of filing of the previously filed foreign application, already a legal representative or assign of that person. This view is necessary to ensure a link between the presently involved application and the earlier filed foreign application with respect to the particular inventor. A contrary interpretation would cause entitlement to benefit to be negotiable as a commodity between unrelated entities. Note that if party Martin or party Fogarty now assigned its involved patent or application to MINTEC, that does not and should not mean party Martin or party Fogarty's involved case should suddenly be entitled to the benefit of the earlier filing dates of party Cragg's European applications, on the basis that the European applications were previously filed by MINTEC who is now the assignee of party Martin or party Fogarty's involved patent or application.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Our view is consistent with the opinion of the Court of Customs and Patent Appeals in Vogel v. Jones, 486 F.2d 1068, 1072, 179 USPQ 425, 428 (CCPA 1973), wherein the court determined that a foreign application made by the assignee of a U.S. applicant, on behalf of one other than the United States inventor, is irrelevant to the rights of priority of the U.S. inventor. The Vogel case concerns 35 U.S.C. § 119, not 35 U.S.C. § 116 or § 120. Contrary to a suggestion by party Cragg in its reply brief at final hearing, Vogel has not been made outdated by statutory amendments to 35 U.S.C. § 116 and § 120 in 1984. The inventive entity may not always be identical between a U.S. application as a whole and an ancestral corresponding application in a foreign application. E.g., Reitz v. Inoue, 39 USPQ2d 1838, 1840 (Bd. Pat. App. & Int. 1996) ("the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application as joint inventors wrought by the 1984 amendment of 35 U.S.C. § 116."). But with regard to any particular invention at issue or involved in an interference, 35 U.S.C. § 119 still includes the language concerning filing in a foreign country by

Interference No. 104,192
Cragg v. Martin v. Fogarty

assigns or legal representatives of the one who files for that invention in the United States.

We have reviewed Schmitt v. Babcock, 377 F.2d 994, 153 USPQ 719 (CCPA 1967), a case mentioned by Cragg during oral argument at final hearing as somehow being in support of its position, but it does not help Cragg's position. The Schmitt case, from a pre-1984 era, relates to an inconsistency or disagreement in inventorship between the U.S. application and the foreign application and a resolution of that disagreement prior to accordance of benefit. Here, inconsistency or disagreement in inventorship is not the issue. Nothing in Schmitt purports to not recognize the filing by assigns requirement of 35 U.S.C. § 119. Even if it does, that would be contrary to the Vogel case which is later in time and thus takes precedent over Schmitt.

It is not in dispute that the assignment from Michael D. Dake to Mintec, Inc. occurred subsequent to the filing of the two European applications. In its request for reconsideration (Paper No. 137) of the granting of Fogarty's preliminary motion 12, on pages 4-5, Cragg stated:

Mintec, the applicant in the EP applications in question, was the assignee of both Dr. Cragg and Dr. Dake, albeit the assignment by Dr. Cragg came several months after those applications had been filed and the assignment by Dr. Dake came more than a year after they had been filed.

Interference No. 104,192
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Note Cragg's exhibit CE-1025, an assignment document from Mr. Michael D. Dake to MinTec, Inc., which was executed on May 6, 1996, more than two years after the filing of EP94400284.9, and nearly two years after the filing of EP94401306.9.

Cragg's brief at final hearing does not appear to argue that under 35 U.S.C. § 119, a subsequent assignment puts an assignee in the same position as if it were a "legal representative" or "assign" of the inventor at a previous time when a foreign application for the same invention was filed by that assignee. In any event, that argument, if made, would be rejected because it ignores plain statutory language to the contrary. Cragg has not set forth evidence of legislative history which clearly indicates that the statute does not mean what it plainly says.

Two new arguments have been raised for the first time by party Cragg in its reply brief at final hearing, which should have been raised, if at all, in its opposition to Fogarty's preliminary motion 12. The first new argument is this: That the two European applications were filed by MINTEC SARL for an invention "actually made" by Michael D. Dake and Andrew H. Cragg, regardless of assignment, and that this should satisfy the filing by assign or legal representative requirement of 35 U.S.C. § 119. The second new argument is raised by the last sentence on page 10 of Cragg's reply brief, which reads: "There is no requirement

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either in Section 119 or in case law that the assignment must have been perfected before the EP applications were filed in order to rely on those applications for priority purposes." The statement implies that somehow there was at least an obligation of assignment which only was not perfected or formalized until after the filing of the European applications, and that this should satisfy 35 U.S.C. § 119.

The two new arguments were not in Cragg's opposition to Fogarty's preliminary motion 12, and still not in Cragg's request for reconsideration of the motion panel's decision on Fogarty's preliminary motion 12. They further still do not appear to be contained in Cragg's principal brief at final hearing. These arguments do not involve mere statutory construction, but are also fact determinative. If the new arguments were timely raised in Cragg's opposition to Fogarty's preliminary motion 12,

In its principal brief at final hearing on page 24, Cragg states: "Michael Dake had assigned his invention to Mintec and his collaboration with Andrew Cragg on the claimed invention prior to the filing of the EP applications is acknowledged. CE1025-1." This cannot be reasonably construed as an argument that the European applications filed by MINTEC SARL were for an invention actually made by Michael D. Dake and that that would satisfy the filing by assigns requirement of 35 U.S.C. § 119. In any event, raising such an argument for the first time in the principal brief at final hearing would nonetheless be untimely. Exhibit CE1025 also does not speak of any "collaboration" in the sense of there being a common goal, but mere discussion, consultation, and communication between Michael D. Dake and one or more of Messrs. Goicoechea, Cragg, and Hudson on a topic and "whatever contributions Dr. Dake may have made" (Emphasis added).

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pertinent facts could have been presented by both parties and Fogarty would have had an opportunity to explore and possibly discredit Cragg's assertions. We decline to entertain new arguments which were not presented in Cragg's opposition to Fogarty's preliminary motion 12.

Accordingly, we address only those arguments of Cragg which were raised in its opposition to Fogarty's preliminary motion 12.

Cragg argues that Fogarty's preliminary motion 12 was based on the representation in Cragg's preliminary statement that Michael D. Dake was the inventor for the subject matter of the count, and yet applicable precedent indicates that preliminary statements can only be used as an effective admission of the earliest or limiting date of invention provable by the party. Cragg's argument overlooks the 1984 changes to 35 U.S.C. § 116 and a corresponding change to 37 CFR § 1.622 regarding the content of preliminary statements. Cragg's argument is rejected.

There are many precedents, including the one cited by Cragg, Dewey v. Lawton, 347 F.2d 629, 631, 146 USPQ 187, 188 (CCPA 1965), which set forth the law that the date alleged in a party's preliminary statement only constitutes a limiting date. Thus, although a party may prove a date of invention that is earlier or later than the alleged date, it cannot be entitled to a date that is prior to the alleged date. Those cases all focus on

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the assertion of a date of invention and are not concerned with any identification of inventorship in the preliminary statement. Identification of inventorship did not become a requirement for preliminary statements until an amendment was made to 37 CFR § 1.622 in 1984 when Title 35, United States Code, was amended to provide that not every named inventor has to have made a contribution to every claim in a patent application. In pertinent part, 35 U.S.C. § 116 now states:

§ 116 Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

Thus, when an application is filed which names multiple inventors, it is not known which inventor(s) contributed to the subject matter of which claims, or to the count in an interference, even though that information may be relevant to the requirements for accordance of benefit in an interference. Rule 1.622, as amended in 1984, partially addresses that problem by requiring in a preliminary statement identification of the inventors of the subject matter of the count. It reads, in pertinent part:

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(a) A party's preliminary statement must identify the inventor who made the invention defined by each count and must state on behalf of the inventor the facts required by paragraph (a) of §§ 1.623, 1.624, and 1.625 as may be appropriate. . . .

Thus, the established precedent focusing on the effect of assertions of invention dates and not concerned with identification of inventorship are not apposite.

Cragg argues:

Rule 629, entitled "Effect of preliminary statement," is the only rule that addresses the consequences for allegations made in a preliminary statement, such consequences being limited to dates and issues of proving priority. Importantly, Rule 629 was amended at the same time Rule 622 was amended (in 1984) to require identification of inventors in a preliminary statement, but the amendment did not create an admission as to inventorship. Rule 629(a) states:

A party shall be held to any date alleged in the preliminary statement. Doubts as to definiteness or sufficiency of any allegation in a preliminary statement . . . will be resolved against the party filing the statement by restricting the party to its effective date or the latest date of a period alleged in the preliminary statement.
(Emphasis in original).

But again, this rule focuses on the effect of assertions as to a date of invention. It is concerned with ambiguities or indefiniteness in the assertion of a date of invention, and is not concerned with anything about the naming of inventors. The rule gives notice of something not so plain and obvious, i.e., that if a range of dates is asserted, then the party making the

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assertion is limited to the latest of such dates. For instance, if a party asserts that its invention was made in a period from January through March of a certain year, then the earliest date of invention the party is entitled would be March 31st.

There need not be a rule to state that which is plainly so, e.g., that what a party represents to an administrative tribunal or an opposing party can be used against the party if the representation is relevant to an adjudication of the party's own rights or the rights between the parties. Party Cragg is not charged with a crime and is not being interrogated in a criminal investigation such that it must be "mirandized" -- warned that anything it says can and will be used against it in a court of law -- before it makes a usable statement. What is important is that party Cragg be given an opportunity to explain or correct any misstatement it might have made and which has been relied upon by either the tribunal or the opposing party. There was ample such opportunity in this case.

Concurrently with the filing of its opposition to Fogarty's preliminary motion 12, Cragg filed a motion under 37 CFR § 1.628 to amend or correct its preliminary statement, to name not just Michael D. Dake as the only inventor of the subject matter of the count, but Andrew H. Cragg and Michael D. Dake as co-inventors. That was a full opportunity for party Cragg to present all the

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evidence it wanted to present on the issue, to demonstrate that it had made an error in only naming Michael D. Dake as the inventor of the subject matter of the count. That motion was denied on April 7, 2000, in Paper No. 130. Party Cragg requested reconsideration of that decision. The original decision was adhered to in a reconsideration decision on June 27, 2000, in Paper No. 146. Party Cragg has not sought review of that decision at final hearing.

Party Cragg further argues that the outcome here is unfair because as the original senior party it need not have filed a preliminary statement, and if it did not file a preliminary statement, then none of this would have ensued. The argument is rejected. If Cragg had not filed a preliminary statement, it would not have revealed information which ultimately led to its being deprived of benefit to the earlier filing dates of foreign applications. But this result is not unfair if, as it is here, all pertinent information were known, Cragg would not be entitled, under the law, to those earlier filing dates. Cragg had ample opportunity to show that the information it had first given was a mistake but failed to make a successful showing.

When 35 U.S.C. § 116 was amended in 1984 to permit co-inventors to be jointly listed as inventors without all of them having contributed to each and every claim in an application, a

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corresponding change was made in 35 U.S.C. § 120 (relating to benefit to the earlier filing date of previously filed United States applications) to require not identity but merely an overlap of inventor(s) between the application seeking benefit and the earlier filed application. The change to 35 U.S.C. § 120 was necessary because additional or non-overlapping inventors may be present due to the inclusion of claims drawn to different subject matter. No such change was necessary; however, with respect to the requirement of 35 U.S.C. § 119 that the person who has filed for a patent on an invention (here the invention of the count) must have previously regularly filed for a patent on the same invention in a foreign country, whether it is through legal representatives or assigns. Indeed, no change was made. The contexts and requirements of 35 U.S.C. § 119 and 35 U.S.C. § 120 are different. That Michael D. Dake being a sole inventor for the subject matter of the count is not a problem under 35 U.S.C. § 120 with respect to earlier filed United States applications does not mean Cragg can expect that it should also not be a problem insofar as benefit to foreign applications are concerned. Satisfaction of requirements under 35 U.S.C. § 120 entitles a party only to the earlier filing date of a previously filed United States application, not a foreign application.

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Alternatively, even assuming that Cragg's identification of Michael D. Dake as the only inventor for the subject matter of the count is a mistake and that Cragg has been allowed to amend its preliminary statement to identify both Andrew H. Cragg and Michael D. Dake as co-inventors of the subject matter of the count, that still does not help party Cragg in any meaningful way. Like Michael D. Dake, Andrew H. Cragg also did not assign his rights to MinTec, Inc. until after European application EP94400284.9 was filed on February 9, 1994, and European application EP94401306.9 was filed on June 10, 1994.

Cragg's Exhibit CE1021 is an assignment from Andrew Cragg, Claude Mialhe, George Goicoechea, and John Hudson to MINTEC, INC. It was executed by Andrew H. Cragg on August 22, 1994. Accordingly, MINTEC SARL was not an assignee of either Michael D. Dake nor Andrew H. Cragg when it filed European applications EP94400284.9 and EP94401306.9. In that connection, we vacate the Board's previous finding in paragraph no. 7 of Paper No. 130 which stated: "The European applications EP94400284.9 and EP94401306.9 were filed by the assignee MINTEC SARL on behalf of inventors Andrew H. Cragg, George Goicoechea, John Hudson, and Claude Mialhe." That finding was made when the question of when Andrew H. Cragg assigned his rights was not an issue and also prior to party Cragg's representation to the Board in its request

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for reconsideration of the Board's granting of Fogarty's preliminary motion 12 that Andrew H. Cragg did not assign his rights to Mintec until several months after the European applications were filed. It lacks adequate basis in the record.⁵

Cragg still further argues that because it has been accorded benefit to the September 27, 1994 filing date of application 08/312,881 (granting of Cragg's preliminary motion 7) and because that application claims foreign priority to EP94400284.9 and EP94401306.9, which claim was granted by an examiner and not challenged in this interference, it still should have benefit of the filing dates of EP94400284.9 and EP94401306.9. The argument is without merit.

As the Board's decision on reconsideration (Paper No. 138) has stated on page 6:

Benefit to the two European applications cannot be obtained indirectly through the intermediate application 08/312,881, where the required overlap in inventor/filer is missing between the involved application and the European applications. This is not the same issue as satisfying the "filing within one year requirement of § 119" through an intermediary United States parent application.

⁵ Our authority and discretion to vacate the previous finding does not depend on whether Fogarty has asked the Board to reconsider the finding or when the request by Fogarty was made. We dismiss Cragg's argument that Fogarty was late in asking the Board to reconsider the previous finding.

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Cragg has offered no reason why the above-quoted analysis is erroneous. Here, we add the following observations.

Having benefit to the 9/27/94 filing date of application 08/312,881 means Cragg's involved application is deemed to have been filed not on the actual filing date of June 5, 1995, but on September 27, 1994. That brings Cragg's involved application much closer in time, by approximately 8 months, to any foreign application with respect to which it desires to be accorded benefit. With that shortening of the time gap, it is easier to satisfy the "within twelve months" time requirement of 35 U.S.C. § 119. It does not mean Cragg's involved application stands in the shoes or otherwise takes the place of the earlier filed domestic application. Benefit is still considered from the perspective of the claims or counts at issue in Cragg's involved application. Whether application 08/312,881 is entitled to benefit with respect to any claim contained therein is irrelevant, not at issue, and has not been determined in this proceeding. We are concerned with the claims of Cragg's involved application and the count in this interference. Fogarty is also correct in stating (Opp. Brief at 8):

Cragg's further argument on page 24 that 35 USC § 119 priority "has not been challenged" for Serial No. 08/312,881 also is irrelevant. In the context of an interference, rights under 35 USC § 119 and § 120 arise with respect to an embodiment within the count in a

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benefit application. Hunt v. Treppschuh, 523 F.2d 1386, 187 USPQ 426 (CCPA 1975). It is thus inaccurate to speak of priority between applications without reference to claims and/or a count. (Emphasis in original.)

For the foregoing reasons, Cragg has shown no error in the motion panel's granting of Fogarty's preliminary motion 12.

B. Fogarty's Preliminary Motions 8 and 10

In a decision mailed February 11, 2000 (Paper No. 108), the motions panel denied Fogarty's preliminary motion 8 under 37 CFR § 1.633(e) (1) which sought to declare another interference between proposed new claim 62 of an uninvolved application 08/684,508 of Fogarty and claim 89 of Cragg's involved application 08/461,402, and claim 1 of Martin's involved Patent No. 5,575,817. The decision gave two grounds for denying the preliminary motion:

(1) that the proposed new interference is barred by 35 U.S.C. § 135(b) because no claim which is the same or substantially the same as Martin's supposedly interfering patent claim 1 had been made by Fogarty within the critical one year period of 35 U.S.C. § 135(b); and

(2) that Fogarty failed to demonstrate that there is interference-in-fact between the allegedly interfering claims.

Fogarty argues, first, that we misapplied the requirements of 35 U.S.C. § 135(b) and that if correctly applied, the requirements of 35 U.S.C. § 135(b) are met. Fogarty further

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argues that there is no requirement in 37 CFR § 1.637 or otherwise, in connection with a preliminary motion to declare an additional interference, that the moving party has to demonstrate the existence of an interference-in-fact between the allegedly interfering claims.

1. Interference-In-Fact

According to Fogarty, it can find nothing in the interference rules which requires that in order for a preliminary motion to declare an additional interference to be granted, the preliminary motion must establish or demonstrate that an interference-in-fact exists between the claims sought to be involved in the additional interference. While there may be no express requirement, the decision on preliminary motions (Paper No. 108) on page 53, lines 18-22, states that the requirement is an implicit one:

Secondly, it is implicit that to demonstrate entitlement to the declaration of an additional interference as is requested in Fogarty's motion, Fogarty must demonstrate that there is interference-in-fact between Goicoechea's [Cragg after deleting Goicoechea as a co-inventor] application claim 89 and claim 62 of Fogarty's uninvolved application 08/684,508. (Emphasis added.)

Party Fogarty's brief at final hearing does not explain why it is not an implicit requirement that a motion to have an

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interference declared must demonstrate that the claims said to interfere with each other actually interfere with each other, i.e., that there is interference-in-fact between the allegedly interfering claims. Moreover, the very first sentence of 37 CFR § 1.637(a) is this: "A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion." (Emphasis added).

We decline to simply take a moving party's word that one of its claims interferes with one or more claims of other parties. We reiterate our holding in the decision on preliminary motions that it is an implicit requirement for a preliminary motion to have another interference declared that the motion must demonstrate that there is interference-in-fact between the allegedly interfering claims. Fogarty's brief at final hearing does not address the point of "implicit" requirement and thus has not shown that the motion panel was erroneous.

Fogarty also asserts that in any event the Board's two-way interference-in-fact analysis follows the Trial Section's precedential decision in Winter v. Fujita, 53 USPQ2d 1234 (Bd. Pat. App. & Int. 1999), but that was not the criteria in October 1998 when preliminary motions were filed in this proceeding. We suppose that what Fogarty is arguing is that had it known of the two-way analysis requirement at the time it filed its preliminary

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motion 8, it could have tried to demonstrate satisfaction of the two-way requirement. That is true, but as was explained in our initial decision, Fogarty has failed to explain why there is interference-in-fact, in either direction, e.g., neither from Martin's claim 1 or Cragg's claim 89 to Fogarty's claim 62, nor from Fogarty's claim 62 to Martin's claim 1 or Cragg's claim 89.⁶ Note also that the declaration of an interference is a discretionary matter. See Ewing v. Fowler Car Co., 244 U.S. 1, 10-11 (1917) (explicitly rejecting the assertion of an applicant's right to declaration of an interference). It is not an abuse of discretion to not declare an interference where the moving party has not demonstrated that there is a conflict or interference-in-fact between opposing claims; regardless of whether the interference rules expressly require a demonstration of conflicting subject matter or interference-in-fact.

⁶ The motion panel's decision observed that Fogarty's position that Cragg's claim 89 and Martin's claim 1 are unpatentable over prior art while Fogarty's claim 62 is patentable over that same prior art is contrary to the position that Fogarty's claim 62 defines the same patentable invention as Cragg's claim 89 and Martin's claim 1. Fogarty's brief at final hearing points out that the motion panel rejected Fogarty's prior art argument and that Cragg has not sought review of that issue. But at best the circumstance pointed out by Cragg only eliminates an apparent inconsistency. It does not demonstrate affirmatively that the claims define the same patentable invention.

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2. 35 U.S.C. § 135(b) Bar

There is no dispute that Fogarty's amendment in its uninvolved application 08/684,508, proposing to add claim 62 to provoke an interference with claim 89 of Cragg's application 08/461,402 and claim 1 of Martin's Patent No. 5,575,817, is filed more than one year after the date of issuance of Martin's Patent No. 5,575,817. The question at issue is whether Fogarty had another claim, drawn to the same or substantially the same invention as Martin's claim 1, that was pending within one year subsequent to the date of issuance of the Martin patent. If so, claim 62 is not barred. If not, then claim 62 is barred.

In pertinent part, 35 U.S.C. § 135(b) states:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Even though the new interference proposed by Fogarty involves claim 1 of Martin's patent, Fogarty attempted to demonstrate that it had a claim drawn to substantially the same subject matter as Martin's claim 1 by showing that it was claiming, within the critical one year period, the same invention as Martin's claim 2. Martin's claim 2 depends from claim 1 and in independent form represents the count of this interference.

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In the motion panel's initial decision (Paper No. 108, pages 52-53), it was stated:

There is no indication anywhere by any party that Fogarty's uninvolved application 08/684,508 had a claim drawn to substantially the same subject matter as Martin's claim 2. While Fogarty's involved application [08/463,836] in this interference include claims which correspond to the count which is Martin's claim 2, that does not mean Fogarty's uninvolved application 08/684,508 has at any time included a claim drawn to substantially the same subject matter as Martin's claim 2.

In its brief for final hearing, Fogarty argues that so long as it was claiming the required subject matter in some earlier application within one year of the issuance of the Martin patent, it passes muster under 35 U.S.C. § 135(b). Fogarty cites two decisions of the Court of Customs and Patent Appeals, In re Schutte, 244 F.2d 323, 113 USPQ 537 (CCPA 1981) and Corbett v. Chisholm, 568 F.2d 759, 196 USPQ 337 (CCPA 1977), two decisions of the Board of Patent Interferences, Tezuka v. Wilson, 224 USPQ 1030, 1036 (Bd. Pat. Int. 1984), Olin v. Duerr, 175 USPQ 707 (Bd. Pat. Int. 1972), and one decision of the Board of Patent Appeals and Interferences, Bowen v. Bihlmaier, 231 USPQ 662 (Bd. Pat. App. & Int. 1986), in support of its view. Fogarty points out that its uninvolved application 08/684,508 is a file wrapper continuation of application 08/255,681, to which it has been

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accorded benefit in this interference and with respect to which Fogarty's involved application is a divisional application.

Cragg's opposition brief does not take up and address the issue as noted above. We find Fogarty's presentation persuasive at least in the circumstances of this case. Consequently, we no longer rely on the above-quoted portion of the motion panel's decision to deny Fogarty's preliminary motion 8.

Another issue, however, nonetheless undermines and precludes the granting of Fogarty's preliminary motion 8. As was explained in the motion panel's decision on page 53:

[W]e disagree with Fogarty's contention that if a claim the same as Martin's claim 2 is made in an application, then a claim the same as Martin's claim 1 is also necessarily made, simply because Martin's claim 2 depends from Martin's claim 1 and thus includes all features of Martin's claim 1. The case cited by Fogarty, In re Schutte, 244 F.2d 323, 113 USPQ 537 (CCPA 1981), does not hold that so long as every feature of a claim is present in another claim then substantially the same subject matter is being claimed. In Schutte, no other difference between two claims is at issue, except for the one which the Court regarded as different in language but same in substance.

Fogarty's view leads to the erroneous result that a claim directed to patentably distinct and separately patentable subject matter as that of another claim can be regarded, at the same time, as claiming the same or substantially the same invention as that other claim. Party Cragg should note that Martin's claim 2 can be separately patentable and patentably distinct from

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Martin's claim 1 even though it depends from claim 1 and undoubtedly includes every limitation of claim 1.

Because it is important that we fully address Fogarty's arguments, we reproduce portions of Fogarty's brief below (Br. at 7-8):

Fogarty responded to Cragg's assertion of noncompliance with 35 USC § 135(b) by noting that the determination under the statute is:

[W]hether the claim which was pending had all the material limitations of the patent claim. *In re Schutte*, 244 F.2d 323, 113 USPQ 537 (CCPA 1981). If the pending claims had all the material limitations there is compliance with the statute even if different language is employed. [Fogarty Reply, p. 5, original italics]

This principle of law has been applied for at least half a century, as is apparent from the authorities cited in the last two paragraphs on page 5 of Fogarty's Reply, i.e., *Ex parte Bowen*, 80 USPQ 106 (Bd. App. 1947), *Stalego v. Heymes*, *supra*, *Olin v. Duerr*, *supra*, and *In re Schutte*, *supra*.

The decision adopted Cragg's argument but with one possible exception did not address (nor acknowledge) the precedents cited by Fogarty.

The test in each of *Bowen*, *Stalego*, *Olin* and *Schutte* for determining compliance with 35 USC § 135(b) is straight forward: is a limitation of the patent claim material and if so, is it claimed by the applicant, expressly or inherently? [Footnote omitted] Application of this test to different fact patterns is seen in a comparison of the results in, for example, (i) *Corbett v. Chisholm*, *supra*, where there was no compliance because a limitation was material but was neither disclosed nor inherent, (ii) *Bowen v.*

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Bihlmaier, *supra* where compliance was found because the material limitation was substantially claimed albeit in different language, (iii) *Connin v. Andrews*, 223 USPQ 243 (Bd. Pat. Int'l. 1984) where the limitation, while material and undisclosed, was inherent, and (iv) *Pizzurro v. Pfund*, 1 USPQ2d 1056 (Bd. Pat. Int'l. 1984) where a limitation was material and claimed.

In our view, none of the authorities Fogarty cites sets forth the principle that so long as every material limitation of a patent claim is included in an applicant's claim, then the applicant has claimed substantially the same invention as the patent claim regardless of whether the applicant's claim includes additional features which may render the applicant's claim patentably distinct or separately patentable from the patent claim.

Except for In re Tanke, 213 F.2d 551, 102 USPQ 83 (CCPA 1954), Stalego v. Heymes, 263 F.2d 334, 120 USPQ 473 (CCPA 1959), Wetmore v. Miller, 477 F.2d 960, 177 USPQ 699 (CCPA 1973), and Corbett v. Chisholm, 568 F.2d 759, 196 USPQ 337 (CCPA 1977), none of the other cases cited by Fogarty⁷ for determining whether substantially the same invention was being claimed by an

⁷ Not Rieser v. Williams, 255 F.2d 419, 118 USPQ 96 (CCPA 1958); not In re Schutte, 244 F.2d 323, 113 USPQ 537 (CCPA 1981); not Ex parte Bowen, 80 USPQ 106 (Bd. App. 1947); not Olin v. Duerr, 175 USPQ 707 (Bd. Pat. Int. 1972); not Connin v. Andrews, 223 USPQ 243 (Bd. Pat. Int. 1984); not Pizzurro v. Pfund, 1 USPQ2d 1056 (Bd. Pat. Int. 1984); not Bowen v. Bihlmaier, 231 USPQ 662 (Bd. Pat. App. & Int. 1986).

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applicant discussed as an issue whether the applicant's claim contained additional features which made the application claim not substantially the same as the patent claim. Fogarty too strictly applied the principle that if every material feature of the patent claim is present in the application claim then substantially the same invention is being claimed by the applicant. The mistake lies in not recognizing that the applicant's claim may include material features that render the applicant's claim patentably distinct and separately patentable from the patent claim.

In Stalego v. Heymes, 263 F.2d 334, 335, 120 USPQ 473, 475 (CCPA 1959), the Court of Customs and Patent Appeals stated:

Those decisions, [citing to precedents] hold, in effect, that claims are not for substantially the same subject matter if one of them contains one or more material limitations which are not found in the other. Accordingly, the ultimate question to be decided in such cases is generally whether specific differences between claims are material; and that is a question which must be decided largely on the basis of the particular circumstances of each case.

In Stalego, the Court reviewed the additional features of the reissue applicant's claim and stated that it did not regard any of those limitations as important. In analyzing the additional features claimed by the reissue applicant, the Court in Stalego, 263 F.2d at 338, 120 USPQ at 477, referred to one feature as not having criticality and another as adding nothing of consequence.

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The key is that the limitations of the applicant's claim at issue must be examined and are relevant too for materiality, not just the features of the patent claim. In Wetmore v. Miller, 477 F.2d 960, 177 USPQ 699, 701 (CCPA 1973), the Court of Customs and Patent Appeals cited to Rieser v. Williams, 255 F.2d 419, 118 USPQ 96 (1958) and Stalego v. Heymes, 263 F.2d 334, 120 USPQ 473 (1959), as setting forth the criterion that has been adopted by the CCPA for determining the applicability of section 135(b).

We do not regard Wetmore v. Miller as making any change to the criterion set forth in Stalego v. Heymes. Evidently, neither does Fogarty. In Wetmore, in light of the additional "fusible" limitation contained in the applicant's claim, the Court stated that the Board made too much emphasis on the fact that the patent claim applies to multiple embodiments and gave insufficient weight to embodiments in the patent using a heat fusible member. Note that the patent claim utilized means-plus-function features under 35 U.S.C. § 112, sixth paragraph. Clearly, the Court considered the technical significance of features in the applicant's claim in a comparison with the claim of the patentee.

In Corbett v. Chisholm, supra, and as Fogarty itself has noted, (Reply at 6, lines 19-25), in response to a restriction requirement the applicant elected to prosecute apparatus claims instead of method claims as the patentee had claimed and the

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patentee's method could be practiced with apparatus materially different from that which the applicant elected. On that basis, the Court held that the applicant's claim and the patentee's claim defined patentably distinct inventions. Thus, the applicant was not claiming substantially the same invention as the patentee. What this suggests is that the features claimed by the applicant, over and above that which is claimed by the patentee, are important and cannot be ignored.⁸

As for In re Tanke, 213 F.2d 551, 102 USPQ 83 (CCPA 1954), it does not hold, as Fogarty argues on page 8 of its reply, that "a mere distinction in breadth or scope" does not define a separate invention. The language of In re Tanke must be read in context. What it actually conveys is that where the subject matter of the differently claimed inventions has already been determined as being directed to substantially the same invention, the specific variations are a mere distinction in breadth or scope within the same or substantially the same subject matter and thus do not define separate inventions or inventions which are not substantially the same. Note that In re Tanke states, 213 F.2d at 555, 102 USPQ at 85:

⁸ Note also that other claims of the applicant did not include one or more material features of the patentee's claim.

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Furthermore, it should be noted that the terms "draft structure" defined by appellants' original claims 6 and 14, and the terms such as "drawbar-receiving member" and "bail-receiving member" in the appealed claims seem to be merely different expressions for essentially the same apparatus both structurally and functionally.

The final conclusion of the board in this case holding that the recitation of the draft structure in the appealed claims "to be different in scope from that recited in claim 14" does not appear to legally establish that such claims are not for substantially the same subject matter.

In dealing with competing claims, one group of which was drawn to a spring which assisted in both lifting and lowering certain plow beams therein defined, and another group which merely defined the function of the spring as assisting in the lifting of said beams, the Supreme Court held that both groups of claims were for the same combination; . . . and that such [one group of] claims should they consist of nothing more than a mere distinction in breadth or scope when compared to the [other group of] patented claims, do not define a separate invention or subject matter which is not substantially the same. Miller v. Eagle Manufacturing Co., 151 U.S. 186 [citations omitted]. (Emphasis added.)

Fogarty's claim 27, the same as original claim 27 in Fogarty's parent application 08/255,681 filed on June 8, 1994, was made within the one-year of November 19, 1996, the date of issuance of Martin's Patent No. 5,575,817. Even assuming that claim 27 includes every feature of Martin's dependent claim 2, and therefor it must include every feature of Martin's independent claim 1, that does not mean Fogarty had claimed substantially the same invention as Martin's claim 1. Martin's

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independent claim 1 formed the basis of the count in related Interference No. 104,083. Martin's dependent claim 2 forms the basis of the count in this interference (See Paper No. 16). Martin's claim 2 adds a feature which is not present in Martin's claim 1. Fogarty had notice that the examiner regarded Martin's claim 2 as patentably distinct from Martin's claim 1. On page 3 of the examiner's Rule 1.609(b) submission, it is stated:

Distinction between Counts 1 and 2.

The important feature of count 1 [the count in Interference 104,083] is that the bifurcated prosthesis has two limbs but only one limb extends across the bifurcation and into the lumen of the vessel. Count 2 [the count in this interference] requires an additional stent to be added to the short limb, thus making a two piece graft that extends into both branches of the vessel. The count 2 is patentably distinct from count 1 for this reason.

Moreover, on page 9 of Fogarty's preliminary motion 8, Fogarty expressly recognized that the USPTO has regarded the counts of Interference No. 104,083 and this interference, represented by Martin's claims 1 and 2, as being directed to separately patentable inventions. Fogarty did not challenge that position. Instead, Fogarty stated that "[t]he same would apply to the Count of the present interference and proposed Count F-2 [for the additional interference]."

In summary, according to Fogarty, because its claim 27 was pending within the critical one-year period of 35 U.S.C. § 135(b)

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and because claim 27 includes every feature of Martin's dependent claim 2, and therefore Martin's independent claim 1, Fogarty was claiming substantially the same invention as Martin's claim 1 within the critical one-year period of 35 U.S.C. § 135(b). We reject Fogarty's argument, because it regards as irrelevant whether the additional feature added by Martin's dependent claim 2 renders Martin's claim 2 patentably distinct and separately patentable from Martin's claim 1. If it is, as it apparently is so based on the examiner's Rule 1.609(b) submission, a position Fogarty has not disputed and in fact urged as similarly true with the count in this interference as compared to the proposed count (see Fogarty's preliminary motion 8, Section 7 on page 9), then Fogarty cannot be deemed as claiming substantially the same invention as Martin's claim 1 by way of having a claim the same as Martin's claim 2.⁹ Fogarty has failed to demonstrate that it had been claiming substantially the same invention as Martin's claim 1 within the one-year period of 35 U.S.C. § 135(b).

3. Cragg's Assertion that claim 62 of Fogarty's uninvolved application is unpatentable under 35 U.S.C. § 112, first and second paragraphs.

⁹ This is in contrast with the applicant's claiming the same patentable invention as the patentee but merely adds features which are of no criticality or significance. See Stalego v. Heymes, 263 F.2d at 338, 120 USPQ at 477.

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In opposing Fogarty's preliminary motion 8, Cragg never asserted that any claim of Fogarty was unpatentable for indefiniteness under 35 U.S.C. § 112, second paragraph. The brief for final hearing is not an occasion to be raising such issues for the first time. Accordingly, we decline to entertain Cragg's argument that claim 62 of Fogarty's uninvolved application is unpatentable under 35 U.S.C. § 112, second paragraph.

The motion panel's decision on preliminary motions (Paper No. 108) stated that it was manifestly apparent based on the entirety of the pleadings that claim 62 and not claim 63 of Fogarty's uninvolved application was the claim at issue in connection with Fogarty's motion to have an additional interference declared. It further found that parties Cragg and Martin would not be prejudiced by a recognition that Fogarty's motion concerned claim 62 of Fogarty's uninvolved application. While opposing Fogarty's motion, Cragg asserted that Fogarty's claims 62 and 63 are unpatentable under 35 U.S.C. § 112, first paragraph, but meaningfully discussed only the features of Fogarty's claim 63. Because nothing meaningful was presented with regard to Fogarty's claim 62, the decision on preliminary motions did not discuss Cragg's mere conclusion that Fogarty's claim 62 is unpatentable under 35 U.S.C. § 112, first paragraph.

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In its opposition brief at final hearing, Cragg asserts that claim 62 of Fogarty's uninvolved application 08/684,508 is unpatentable under 35 U.S.C. § 112, first paragraph, and makes a detailed analysis, for the first time, as to why the assertion has merit. This substantive analysis directed to Fogarty's claim 62 was not previously provided in Cragg's opposition to Fogarty's preliminary motion 8. Accordingly, such analysis will not be entertained for the first time at final hearing.

We will not compare Fogarty's claims 62 and 63 and attempt to figure out which features are common therebetween such that when Cragg discussed a certain feature of claim 63 when opposing Fogarty's preliminary motion 8 it was the same as if it were discussing a corresponding feature in Fogarty's claim 62. It was incumbent upon Cragg when opposing Fogarty's motion to clearly set forth why Fogarty's claim 62 is unpatentable under 35 U.S.C. § 112, first paragraph. It is not the role of the Board to act as an advocate for either party by making arguments, presentations, or comparisons which should have been made by the parties themselves.

Because no meaningful argument was presented by Cragg in its opposition to Fogarty's preliminary motion 8 as to why claim 62 of Fogarty's uninvolved application 08/684,508 is unpatentable under 35 U.S.C. § 112, first paragraph, we reject Cragg's

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argument at final hearing that claim 62 of Fogarty's uninvol ved application 08/684,508 is unpatentable under 35 U.S.C. § 112, first paragraph.

Alternatively, even if we do consider the substantive arguments made for the first time by Cragg in its opposition brief at final hearing concerning claim 62 of Fogarty's uninvol ved application 08/684,508, the arguments are without merit and do not make out a prima facie case that claim 62 of Fogarty's application 08/684,508 is without written description support in the specification.

According to Cragg, the features (1) a first leg joined to said anchor section, and (2) means for joining a second leg to said anchor section, of claim 62 of Fogarty's uninvol ved application 08/684,508 are without support in the specification of application 08/684,508. Cragg contends that "Fogarty's first leg is never joined to an anchor section." Cragg explains that Fogarty's first leg is positioned within a fiber fabric liner at a location spaced below the anchor section. According to Cragg, Fogarty's second leg is also not joined to the anchor section, evidently for the same reason, and thus there can be no description for a "means for joining a second leg to said anchor section." Cragg's arguments assume that there must be direct contact between the first leg and the anchor section and between

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the second leg and the anchor section. We see no reason, however, to construe claim 62 of Fogarty's uninvented application 08/684,508 so narrowly as to require direct or immediate contact between the first and second legs and the anchor section.

Cragg does not contend that Fogarty's application 08/684,508 sets forth a special definition for the word "join" that is different from the ordinary meaning of the term. We understand the word "join" as sufficiently broad to encompass an indirect connection through an intermediate member. See, for example, Merriam-Webster's Collegiate Dictionary, Tenth Edition, Copyright © 1999, which defines "join" as follows:

- 1 a: to put or bring together so as to form a unit . . . b: to connect (as points) by a line c: ADJOIN 2: to put or bring into close association or relationship . . . 3: to engage in (battle) 4 a: to come into the company of . . . b: to associate oneself with . . .

If the first and second legs in Fogarty's application 08/684,508 are connected to the anchor section by way of a fiber fabric liner, as Cragg apparently indicates, that does not mean the first and the second legs are not joined to the anchor section.

Cragg argues that the tubular liner means cannot also be the means for joining because if it is then that would render meaningless the tubular liner means element of claim 62. The argument is without merit, because the recitation of a tubular liner means in claim 62 further specifies that the liner

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structure defines a continuous flow path from the anchor section to the first leg and an opening disposed toward the second branch lumen. We note further that nothing precludes the same disclosed physical element from being the corresponding structure of two or more means-plus-function elements in a claim, provided that the structure performs the recited functions of those means-plus-function clauses.

4. Fogarty's argument that notwithstanding any 35 U.S.C. § 135(b) bar relative to patentee Martin, Fogarty is not precluded from having an interference with Cragg is without merit

Fogarty points out that in related Interference No. 104,083 involving only Martin and Cragg, specifically Cragg claim 89 and Martin claim 1, judgment has been entered against patentee Martin and thus claim 1 of Martin is as good as cancelled. According to Fogarty, the time bar under 35 U.S.C. § 135(b) is for protecting patentees from perpetually under threat of an interference proceeding initiated by applicants. Thus, Fogarty argues that because judgment has been entered against Martin's patent claim 1 in Interference No. 104,083, protection for Martin under 35 U.S.C. § 135(b) insofar as Martin's claim 1 is concerned is moot and unnecessary. Fogarty's view is that in this circumstance, application of the bar under 35 U.S.C. § 135(b) only protects another applicant, i.e., party Cragg, whose claim 89 would be shielded from a priority determination relative to Fogarty.

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While 35 U.S.C. § 135(b) was primarily enacted to protect patentees, the language of the statute is not such that only a patentee may benefit from the bar. The statutory section is written in terms of a bar on the presentation of a claim, not as a bar on having an interference with a patentee. If an applicant is time-barred by 35 U.S.C. § 135(b) from presenting a certain claim, then it follows that the barred claim cannot serve as the basis of an interference with respect to another applicant whose claim for the same patentable invention is not subject to the bar. Thus, if applicable, the bar under 35 U.S.C. § 135(b) yields an incidental benefit to potentially opposing applicants. The statutory section does not restrict or limit who may benefit from application of the bar, as it only precludes the presentation of a claim. Note that 35 U.S.C. § 135(b) has been upheld as an applicable ground of rejection in ex parte prosecution before the USPTO. In re McGrew, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997).

Fogarty would have us read into 35 U.S.C. § 135(b) language that is not there, to turn it into a bar against having certain types of interferences instead of simply a bar on the presentation of certain claims as it so plainly reads. We decline to so distort or add to the statutory language. In our

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view, if Fogarty cannot present a claim, then it cannot have an interference based on that claim with another party, whether that other party is an applicant or a patentee.

Fogarty's claim 62 was presumed by the parties as being for substantially the same invention as Martin's patent claim 1. Because it was presented outside of the one year period from the date of issuance of the Martin patent, and because Fogarty can demonstrate no other claim which was pending prior to the one year period and which was directed to substantially the same invention as Martin's claim 1, Fogarty's claim 62 is barred.

The fact that Martin's patent claim 1 has been determined unpatentable to Martin because of an adverse judgment in Interference No. 104,083 does not help Fogarty. The language of 35 U.S.C. § 135(b) refers to a claim for the same or substantially the same subject matter as "a claim of an issued patent" and does not purport to add the qualifications that such a claim must remain valid, non-canceled, patentable, non-disclaimed, and/or enforceable. We decline to read into 35 U.S.C. § 135(b) these conditions in the absence of a showing by Fogarty of a clear legislative intent to that effect. The operative word is "issued," similar to the word "born." Just as a baby cannot be un-born, an issued claim cannot become non-issued whatever its status becomes subsequent to issuance.

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The public's interest is not harmed by applying 35 U.S.C. § 135(b) the way it is written and enacted by Congress. Fogarty is also under a mistaken belief that it is prejudiced by its not being successful with preliminary motion 8 to get into an interference with Cragg who has a dominating claim. Fogarty's predicament arises from its not having established, in connection with a proposed new interference involving Cragg's claim 89, interference-in-fact with respect to a Fogarty claim that is not time barred under 35 U.S.C. § 135(b). Alternatively, if Fogarty believes that Cragg's dominating claim 89 and any Fogarty claim involved in this interference define the same patentable subject matter, Fogarty could have moved to broaden out the count in this interference to the scope of Cragg's claim 89 and to have Cragg's claim 89 designated as corresponding to the revised new count. Fogarty did not take such action in this case. On these circumstances, that Cragg has a dominating claim not involved in this interference or a new interference with Fogarty does not mean Fogarty has been subjected to prejudice. A dominating claim is not necessarily a claim drawn to the same patentable invention as a dominated claim. In either case, however, with regard to Cragg's allegedly dominating claim 89 Fogarty has shown no prejudice by the denial of its preliminary motion 8.

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5. Fogarty's preliminary motion 10

Fogarty's preliminary motion 10 sought to be accorded benefit of the earlier filing date of application 08/255,681, with respect to the count proposed in connection with Fogarty's preliminary motion 8. Consequently, preliminary motion 10 is contingent upon the granting of preliminary motion 8. Because Fogarty's preliminary motion 8 was properly denied, Fogarty's preliminary motion 10 was correctly dismissed as moot.

6. Cragg's Motion to Suppress

Cragg has filed a motion to suppress five exhibits FE-3001, FE-3002, FE-3004, FE-3005, and CE-1019. These are exhibits identified by party Fogarty, prior to submission of its brief at final hearing, as those which Fogarty intended to rely upon at final hearing in connection with its seeking review of the motion panel's decision of Fogarty's preliminary motion 8. According to Cragg, Fogarty may not rely on these exhibits at final hearing because Fogarty did not rely on these exhibits when filing its preliminary motion 8.

Cragg has not pointed out, and it is not immediately apparent, where in Fogarty's briefs at final hearing are references made to exhibits FE-3001, FE-3002, FE-3004, FE-3005, and CE-1019, or how the substance of these exhibits have been relied upon by Fogarty in meaningful furtherance of any argument.

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Thus, with regard to these exhibits, Cragg has failed to make out a prima facie case of why the motion to suppress should be granted. Alternatively, even without suppressing these exhibits, Fogarty's arguments concerning its preliminary motions 8 and 10 have not been shown to have merit. Accordingly, Cragg's motion to suppress is denied and alternatively dismissed as moot.

C. Cragg's Preliminary Motion 1

In Cragg's preliminary motion 1, it is alleged that Fogarty's claims 41-69, not all of Fogarty's claims corresponding to the count, are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification. Fogarty's claims 42-69 depend either directly or indirectly from claim 41. Cragg's preliminary motion 1 (Paper No. 39, pp. 6-7) specifically identified the following feature of Fogarty's method claim 41 as that which is without written description:

[I]ntroducing into a patient's vasculature an anchor section and first tubular graft of the vascular graft so that the anchor section is disposed within the primary artery and the first tubular graft is disposed within the first branch artery to form a first continuous flow path from the primary artery to the first branch artery.

According to Cragg's preliminary motion 1, the above-quoted feature of Fogarty's method claim 41 requires the anchor section and the first tubular graft to be introduced in a single step, not sequentially as is disclosed in Fogarty's specification. We

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reproduce the following paragraph from page 10 of Cragg's preliminary motion 1, which clearly reveals Cragg's position:

The Fogarty Application fails to suggest introducing an anchor section and first tubular graft in a single step. Instead, the Fogarty Application teaches (1) first introducing the bifurcated base structure so that the anchor section is positioned within a primary vessel; (2) after the bifurcated base structure is anchored, the first tubular graft is introduced into the first connector leg and anchored between the leg and the first branch artery; and (3) the second tubular graft is then inserted into the second connector section and anchored between the described second connector and the second branch artery. See Fogarty Application at Page 6, lines 1-9. (Emphasis in original).

The decision on preliminary motions rejected Cragg's argument, stating (Paper No. 108, p. 10):

We reject Goicoechea's [Cragg's] argument because we do not read or interpret the above-quoted language of claim 41 as requiring that the anchor section and the first tubular graft be introduced "in a single step" or simultaneously. The words "in a single step" do not appear in claim 41, nor do the words "simultaneously," "concurrently," "unison," or any other term which means the same. The language is simply broadly recited and imposes no particular order for the insertion of the anchor section and the first tubular graft.

In its principal brief at final hearing, Cragg does not continue to argue that Fogarty's claim 41 requires that the anchor section and the first tubular graft be introduced in a single step or simultaneously. Rather, a new argument is made through the back door that the claim is so broad that the full

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scope of what is claimed is not described in the specification. Specifically, on page 20 of its brief, in a section entitled "CRAGG MOTION 1 SHOULD BE GRANTED," Cragg states:

If the Board adheres to its broad construction of claim 41 [that no specific sequence of introduction is required], then the Fogarty specification lacks written description for claim 41 because as discussed it only describes the sequential introduction of the anchor section and the first tubular graft but not the introduction of the anchor section and first tubular graft as a unitary structure. There is nothing in the Fogarty application to convey to those skilled in the art that Fogarty was in possession of that aspect of the invention of claim 41, if claim 41 is broadly construed as proposed.

We have again reviewed Cragg's preliminary motion 1 (Paper No. 39). Nothing therein can reasonably be considered as an alternative or contingent argument that if the Board is not persuaded by Cragg's primary argument that Fogarty's claim 41 requires the introduction of the anchor section and the first tubular graft in a single step then the claim is nonetheless not described in the specification because of undue breadth. In the case of Cragg's preliminary motion 1, the one argument actually made is the only argument made. Consequently, the issue now raised by Cragg at final hearing was neither developed and briefed by the parties during the preliminary motions stage of this interference, nor considered by the motions panel when preliminary motions were decided.

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In short, Cragg wants the board to now hold Fogarty's claims 41-69 as being without written description in the specification for a reason other than that articulated and set forth by Cragg in its preliminary motion 1. We decline to consider this new argument at the final hearing stage of the proceeding. Final hearing under the interference rules is not a place to begin preliminary motions afresh. Rather, we are here to review the decision by a three-member motions panel on preliminary motions made by the parties, on the evidence and arguments which formed the basis of the decision on preliminary motions.

A new reason for granting a motion should not be considered at final hearing if it was not included in the original motion and not supported by a showing of good cause why the argument was not earlier presented. Fredkin v. Irasek, 397 F.2d 342, 346, 158 USPQ 280, 284 (CCPA 1968); Koch v. Lieber, 141 F.2d 518, 520, 61 USPQ 127, 129 (CCPA 1944); Bayles v. Elbe, 16 USPQ2d 1389, 1391 (Bd. Pat. & Int. 1990) ("It has been a longstanding practice that a party whose motion was denied cannot present at final hearing grounds not included in the original motion."). It is inappropriate for a party to present arguments in its brief which were not a part of the motion or opposition. Lawson v. Enloe, 26 USPQ2d 1594 (Bd. Pat. App. & Int. 1992).

All reasons for granting a party's desired relief should be advanced in the party's motion. A piecemeal presentation in which a party may start over with new arguments after an adverse decision has been rendered would make an orderly proceeding next to impossible to conduct. Cragg's brief offered no excuse for raising the issue of undue breadth issue so late, more than two years after the filing of Cragg's preliminary motion 1 on October 16, 1998, and ten months after the decision on preliminary motions has been rendered.

Cragg cannot credibly assert that it had no idea that Fogarty's claim 41 can possibly be construed so as to not require the introduction of the anchor section and the first tubular graft in a single step or simultaneously. As the moving party, Cragg was attempting to persuade the Board to adopt a narrow interpretation of Fogarty's claim 41, i.e., that the claim required the introduction of the anchor section and the first tubular graft in a single step or simultaneously. The mere filing of Cragg's motion reflects an awareness that the claim may not be so construed. Cragg was very much on notice that the Board may not adopt the narrow interpretation urged by Cragg. Cragg may not credibly claim to have been blind-sided by the Board's not adopting its position.

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An interference is an inter partes proceeding. The Board may not suitably act as an advocate for either party, either to fill in gaps left open in either party's presentation, or to offer an alternate rationale and to try to fit the facts to that rationale, all on its own, particularly when the considerations are complex and the parties may well differ in their views. In presenting a preliminary motion for judgment, a party may not simply plead a statutory section, e.g., 35 U.S.C. § 112, first paragraph, and then rely on the Board to propose different ways in which the opponent's claims may possibly be attacked as being without written description in the specification. With regard to Cragg's preliminary motion 1, our decision on preliminary motions addressed the arguments made by Cragg. The new argument now presented by Cragg is not entitled to consideration.

For the foregoing reasons, the motions panel properly denied Cragg's preliminary motion 1.

D. Cragg's Preliminary Motion 2

We adopt in its entirety the discussion in our decision on preliminary motions (Paper No. 108), which is reproduced below, and then add a few more comments to address Cragg's brief at final hearing:

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By this motion, Goicoechea [Cragg] alleges that there is no interference-in-fact between its involved application 08/461,402 and Fogarty's involved application 08/463,836. As is stated in 37 CFR § 1.601(j):

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

In that regard, 37 CFR § 1.601(n) states:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". (Emphasis in original.)

Resolution of an interference-in-fact issue involves a two-way patentability analysis. For there to be an interference-in-fact, the parties must each have at least one claim which collectively satisfy the following: The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must

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anticipate or render obvious the claimed invention of Party A.

For a showing of no-interference-in-fact, the burden is on Goicoechea as the movant, see, e.g., 37 CFR § 1.637(a), to demonstrate that all of Goicoechea's claims 55, 59, 62-65, 88 and 90 which correspond to the count do not define the same patentable invention as any one of Fogarty's claims 27-69, or that all of Fogarty's claims 21-69 do not define the same patentable invention as any one of Goicoechea's claims 55, 59, 62-65, 88 and 90. Goicoechea has attempted to show that all of its claims 55, 59, 62-65, 88 and 90 define an invention process which is neither anticipated nor obvious over any one of Fogarty's claims 27-69.

Goicoechea argues that all of its claims include a "long-leg, short-leg" concept which is absent from and not suggested by any one of Fogarty's claims corresponding to the count. Also, apparently referring to the count, the motion on page 10 explains the subject matter "supposedly" in conflict as follows:

The invention that is the subject of this Interference relates to a two-section apparatus comprising (1) a first section configured to be positioned within a

bifurcated lumen and (2) a second section configured to be positioned separately in a branch of the bifurcated lumen and to extend into the bifurcated lumen. A first lower limb of the first section is configured so that it extends into a first leg of the bifurcation when the first section is positioned in the lumen. A second lower limb of the first section, which is shorter than the first lower limb, is configured so that it does not extend into a second leg of the bifurcation. Accordingly, the first section defines a "long-leg, short-leg" concept. Joining two components (the first and second sections) completes the apparatus. (Emphasis in original).

Of all Goicoechea claims which correspond to the count, claims 55, 59 and 90 are independent claims.

Claim 90 is identical to the count. Claim 55 embodies the "long-leg, short-leg" idea by including step (a) -- disposing said proximal portion of said bifurcated prosthesis in said blood vessel such that said first distal portion of said bifurcated prosthesis extends into said first branched vessel [long-leg], and step (c) -- attaching said second prosthesis to said extension portion of said bifurcated prosthesis such that said second prosthesis extends into said second branched vessel [short-leg]. But claim 59 is broad and does not do the same. In that regard, claim 59 is reproduced below:

59. A bifurcated prosthesis for use with an angiographical bifurcation of a blood vessel into two branched vessels comprising a bifurcated proximal portion adapted to be disposed within said blood vessel, a distal portion adapted to extend across the bifurcation into one of the branched vessels, and a separate distal segment joined to said proximal portion and adapted to allow blood to flow from the proximal portion into the other branched vessel.

Goicoechea has not shown that claim 59 requires that whenever the proximal portion is placed within the blood vessel, the first distal portion is already attached to the proximal portion and extending from the blood vessel into a branched vessel and the second distal segment is not yet joined to the proximal portion. Indeed, claim 59 is broad enough to cover the case of two short-legs, i.e., the proximal portion is introduced into the blood vessel first, and then the first distal portion and the second distal segment are introduced in sequence, each extending into a respective branched blood vessel.

For the foregoing reasons, the patentable distinction argued by Goicoechea does not exist with respect to at least Goicoechea's independent claim 59. That alone is sufficient ground to reject Goicoechea's motion for no interference-in-fact. Additionally, with

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respect to Fogarty's claims 41-69, Goicoechea is improperly reading into those claims a specific embodiment from Fogarty's disclosure rather than focusing on the language of the claims themselves. As we discussed in the context of Goicoechea's preliminary motion 1, Fogarty's independent claim 41 is broadly recited and imposes no particular manner for the insertion of the anchor section and the first tubular graft.

Given Fogarty's claim 41, it is left to the discretion of one with ordinary skill in the art just how to introduce the anchor section and the first tubular graft. One with ordinary skill in the art possesses a certain basic level of skill. See, e.g., In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) ([Applicant's] argument presumes stupidity rather than skill). A conclusion of obviousness also may be made based on the common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

In re Bozek, 416 F.2d 1385, 163 USPQ 545, 549 (CCPA 1969). It cannot be reasonably argued that one with ordinary skill in the art is so devoid of skill and

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common sense that he or she would not have readily recognized that the anchor section and the first tubular graft may either be separately inserted and then joined in situ, or inserted as a unitary whole. Those are the only two possibilities with regard to the insertion of the anchor section and the first tubular graft. In our view, selecting one of the two readily apparent choices would have been well within the basic level of skill and common sense possessed by one with ordinary skill in the art. Moreover, it is incumbent upon Goicoechea as the movant to establish why, given Fogarty's independent claim 41, one with ordinary skill in the art would not have known that the anchor section and the first tabular graft can be inserted as one or separately. Goicoechea set forth no persuasive reasons in that regard.

For the foregoing reasons, Goicoechea has failed to demonstrate that all of its claims 55, 59, 62-65, 88 and 90 do not define the same patentable invention as any one of Fogarty's claims 27-69. Goicoechea's preliminary motion 2 insofar as it seeks a judgment based on no interference-in-fact is denied.

Interference No. 104,192
Cragg v. Martin v. Fogarty

As for Goicoechea's assertion that Fogarty's claims 27-69, all of Fogarty's claims which have been designated as corresponding to the count in the declaration of this interference, do not correspond to the count, Goicoechea has to satisfy the requirements set forth in 37 CFR § 1.637(c)(4). Goicoechea has to show that each of Fogarty's claims 27-69 does not define the same patentable invention as any of Goicoechea's claims and Martin's claims whose correspondence to the count Goicoechea does not dispute.

As is already discussed above in connection with Goicoechea's assertion of no interference-in-fact, Goicoechea has not established patentable distinction between Fogarty's claims 41-69 and at least Goicoechea's claim 55 and claim 90, and also between Fogarty's claims 27-69 and at least Goicoechea's claim 59. Goicoechea's preliminary motion 2 to designate Fogarty's claims 27-69 as not corresponding to the count is denied.

Nothing presented by Cragg in its brief at final hearing demonstrates that our above-quoted analysis was in error. Fogarty is correct that Cragg continues to attempt an

Interference No. 104,192
Cragg v. Martin v. Fogarty

inappropriate reading of extraneous limitations from the specification into the claims. Although the specification is useful in interpreting claim language, as the Court of Appeals for the Federal Circuit has nonetheless stated, "the name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). See also Giles Sutherland Rich, Extent of Protection and Interpretation of Claims--American Perspectives, 21 Int' Rev. Indus. Prop. & Copyright L, 497, 499 (1990) ("The U.S. is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claims."). Reading into the claims an extraneous limitation from the specification is simply improper. E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988). In E.I. de Pont, 849 F.2d at 1433, 7 USPQ2d at 1131, the Federal Circuit stated:

It is entirely proper to use the specification to interpret what the Patentee meant by a word or phrase in the claim. See, e.g., Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed. Cir. 1985). But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By "extraneous," we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.

Interference No. 104,192
Cragg v. Martin v. Fogarty

In interpreting its own claims, Cragg in its brief at final hearing begins with a section discussing its disclosure, entitled "Cragg Discloses A Unitary Bifurcated Long Leg/Short Leg Prosthesis" (Emphasis in original). That section ends with this one sentence paragraph:

The specification supports that Cragg's claims require a unitary bifurcated long leg/short leg structure, where "unitary" requires a securing means connecting the portions of the structure.

By the time Cragg made the above-quoted conclusion, it has not yet recited, reproduced, or even referred to any actual language in its claims. That Cragg's specification has a description for a certain embodiment does not necessarily mean that all of Cragg's claims must include the elements of that embodiment. If the claims do not require a unitary structure in the sense that there is a securing means which connects all the parts together, these are extraneous limitations which should not be read into the claims from the specification. Moreover, even Cragg's own specification contains no reference to the term "unitary" on which Cragg now places so much emphasis. Neither does Cragg's own specification contain any reference to words which are generally synonymous with the word "unitary," such as "integral"

Interference No. 104,192
Cragg v. Martin v. Fogarty

or "one-piece." Thus, what Cragg is arguing in this part is many steps removed from the actual language of the claims.

The bifurcated prosthesis according to Cragg's claim 59 requires (1) a proximal portion, (2) a distal portion, and (3) a separate distal segment. Unlike Cragg's claim 55, Cragg's claim 59 does not require disposing the proximal portion in the blood vessel such that the distal portion extends into a first branched vessel. That means claim 59 is sufficiently broad to have the proximal portion put in place without regard to whether the distal portion is also placed in working position.

Cragg argues that because the word "portion" means part of a whole, the proximal portion and the distal portion must be part of a unitary structure in which the proximal portion and the distal portion is unitary or connected together by some securing means before being introduced into the blood vessel. We are not persuaded by Cragg's argument.

While the word "portion" may indeed mean part of a whole or part of something, Cragg has not submitted any evidence that the so called parts of a whole must be physically attached to each other at all times. In that regard, note that a jig-saw puzzle has many parts or portions but the many pieces don't have to be connected to each other before properly being referred to as portions of the same puzzle. Cragg has not made any meaningful

Interference No. 104,192
Cragg v. Martin v. Fogarty

showing that the word "portion" as is ordinarily used in the English language requires an actual physical attachment. Nor has Cragg argued that its specification has specially defined the word "portion" in a manner different from its ordinary usage in the English language. Indeed, Cragg even cites to Merriam Webster's Collegiate Dictionary, 10th Ed. (1994), in its brief at final hearing for the meaning of "portion," which states: "part of something." Note that "part of something" can be conceptual and does not necessarily require a physical connection at all times. Moreover, we note that even Cragg's so called "portions" are not physically connected at all times; indisputably, they have to be preassembled prior to introduction into the patient.

Alternatively, our decision on preliminary motion held that even assuming that the "unitary" feature argued by Cragg is included in all of Cragg's claims corresponding to the count, Fogarty's claim 41 still would have rendered obvious Cragg's claimed invention such as Cragg's claim 59.

Cragg argues (Br. at 18):

The Board states that insertion of the anchor section and the first tubular graft as a unitary whole is only one of two possibilities with regard to the insertion of the Fogarty structure. Paper No. 108, p.15. There is a third possibility ignored by the Board, namely, inserting the anchor section and both tubular grafts at the same time.

Interference No. 104,192
Cragg v. Martin v. Fogarty

The argument is without merit. We stated (Paper No. 108, at 15) that there are "only two possibilities with regard to the insertion of the anchor section and the first tubular graft" (emphasis added). In that context, the second tubular graft is uninvolved, and how it is introduced is irrelevant.

We adopt and reiterate herein the following portion of our decision on preliminary motions concerning Cragg's preliminary motion 2 (Paper No. 108, pp. 14-16):

Additionally, with respect to Fogarty's claims 41-69, Goicoechea is improperly reading into those claims a specific embodiment from Fogarty's disclosure rather than focusing on the language of the claims themselves. As we discussed in the context of Goicoechea's preliminary motion 1, Fogarty's independent claim 41 is broadly recited and imposes no particular manner for the insertion of the anchor section and the first tubular graft.

Given Fogarty's claim 41, it is left to the discretion of one with ordinary skill in the art just how to introduce the anchor section and the first tubular graft. One with ordinary skill in the art possesses a certain basic level of skill. See, e.g., In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) ([Applicant's] argument presumes stupidity rather than skill). A conclusion of obviousness also may be made based on the common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545, 549 (CCPA 1969). It cannot be reasonably argued that one with ordinary skill in the art is so devoid of skill and common sense that he or she would not have readily recognized that the anchor section and the first tubular graft may either be separately inserted and then joined in situ, or inserted as a unitary whole.

Interference No. 104,192
Cragg v. Martin v. Fogarty

Those are the only two possibilities with regard to the insertion of the anchor section and the first tubular graft. In our view, selecting one of the two readily apparent choices would have been well within the basic level of skill and common sense possessed by one with ordinary skill in the art. Moreover, it is incumbent upon Goicoechea as the movant to establish why, given Fogarty's independent claim 41, one with ordinary skill in the art would not have known that the anchor section and the first tabular graft can be inserted as one or separately. Goicoechea set forth no persuasive reasons in that regard.

Cragg dismisses our citation to In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) and In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), by arguing that "[b]oth Bozek and Sovish required a disclosure in the prior art references to render the claims obvious."). It appears that Cragg completely misses the point for which we cited to those cases, i.e., that one with ordinary skill in the art is presumed to possess some logic and skill that is independent of what is disclosed in an item of prior art. Here, the starting point is Fogarty's claim 41. In that sense, Fogarty's claim 41 is the disclosure with which one with ordinary skill in the art is presented, in determining whether claims such as Cragg's claim 59 would have been obvious over Fogarty's claim 41. We agree entirely with the following two paragraphs in Fogarty's opposition brief at pages 14-15:

Second, while Cragg would argue that Sovish and Bozek are somehow anomalous, the principle for which

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Cragg v. Martin v. Fogarty

they were actually cited in the Decision has been repeatedly followed by this Board; e.g., Ex parte Research and Manufacturing Co., 10 USPQ2d 1657, 1664 (Bd. Pat. App. & Intf. 1989) (skill is presumed on the part of the artisan rather than the converse); Ex parte George, 21 USPQ2d 1058, 1060 n.1 (Bd. Pat. App. & Int. 1991) (the ability of one having ordinary skill in the art should not be underestimated); Ex parte Nesbit, 25 USPQ2d 1817, 1823 (Bd. Pat. App. & Intf. 1992) (the law presumes skill on the part of the artisan rather than the converse); Ex parte GPAC Inc., 29 USPQ2d 1401, 1405 (Bd. Pat. App. & Intf. 1993) (the skill of the art must be presumed, not the contrary).

The Board thus found that the worker is not so devoid of skill or common sense that he or she would not have readily recognized that the anchor section and the first tubular graft may either be separately inserted and then joined *in situ*, or inserted as a unitary whole. (Emphasis in original).

Cragg's citation to Al-Site Corp. v. VSI Intern., Inc., 174

F.3d 1308, 1323, 50 USPQ2d 1161 (Fed. Cir. 1999) is inapposite.

The Al-Site case does not stand for the proposition that Fogarty's claim 41 must be combined with another prior art reference in order to render obvious a Cragg claim which corresponds to the count. In contrast, the case supports the position that the perspective from which a prior art reference is viewed is that of a person with ordinary skill in the art.

Cragg further argues that the Board has not explained how, if Fogarty's anchor section and first tubular graft are inserted as one piece, a skilled worker would successfully position that device. According to Cragg, because the first tubular graft of

Interference No. 104,192
Cragg v. Martin v. Fogarty

Fogarty is within the fabric liner leg 28, one ends up with an anchor section-fabric liner-tubular graft assembly that is not rigid and is not supported. The argument is misdirected and in any event unpersuasive. Here, the starting point for the obviousness analysis is not some embodiment disclosed in Fogarty's specification, but Fogarty's claim 41 which does not require placing the first tubular graft in a fabric liner leg. Moreover, in any event Cragg has submitted no meaningful evidence in the form of declaration or affidavit testimony from anyone to establish that one with ordinary skill in the art would not have known how to introduce the anchor section together with the first tubular graft. As Fogarty has pointed out in its opposition brief, attorney argument cannot take the place of evidence lacking in the record. See, e.g., Knorr v. Pearson, 671 F.2d 1368, 1373, 213 USPQ 196, 200 (CCPA 1982); Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

Cragg's preliminary motion 2 further seeks to have all of Fogarty's claims corresponding to the count, i.e., claims 27-69, designated as not corresponding to the count. We ruled in the decision on preliminary motions that per 37 CFR § 1.637(c)(4), the motion is without merit because it failed to demonstrate that

Interference No. 104,192
Cragg v. Martin v. Fogarty

each of Fogarty's claims 27-69 does not define the same patentable invention as any of Cragg's claims and Martin claims whose correspondence to the count is not disputed by Cragg.

Cragg's arguments with regard to designating Fogarty's claims as not corresponding to the count is merely a reference to its arguments alleging no interference-in-fact between Cragg's claims and Fogarty's claims. Cragg evidently is of the view that if it has demonstrated no interference-in-fact between its claims and Martin's claims on the one hand and Fogarty's claims on the other hand, then the case has been made that Fogarty's claims corresponding to the count should be designated as not corresponding to the count. But Cragg has failed to demonstrate no interference-in-fact between its claims and Martin's claims on the one hand and Fogarty's claims on the other hand. Thus, no reason has been shown to designate Fogarty's claims 27-69 as not corresponding to the count. Note also that even if there was no interference-in-fact with respect to any Fogarty claim, Fogarty's application would become uninvolved and there would be no need to designate any of its claims as not corresponding to the count.

For the foregoing reasons, Cragg has shown no error in the denial of Cragg's preliminary motion 2.

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Cragg v. Martin v. Fogarty

Judgment

It is

ORDERED that judgment as to the subject matter of the count is herein entered against junior party ERIC C. MARTIN and also against junior party ANDREW H. CRAGG and MICHAEL D. DAKE;

FURTHER ORDERED that the junior party ERIC C. MARTIN is not entitled to his patent claims 2-17 which correspond to the count;

FURTHER ORDERED that junior party ANDREW H. CRAGG and MICHAEL D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and 90 which correspond to the count; and

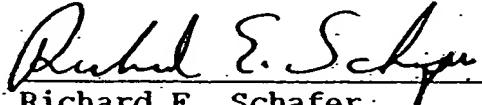
FURTHER ORDERED that a copy of this paper shall be given a paper number and filed in the respective involved application/patent of the parties.¹⁰

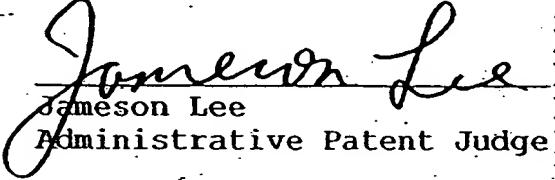
¹⁰ Failure to file a copy of any agreement regarding the termination of this proceeding may render the agreement and any resulting patent unenforceable. See section 35 U.S.C. § 135(c) and 37 CFR § 1.661.

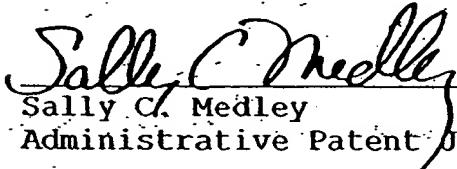
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Cragg v. Martin v. Fogarty

m9K

Fred E. McKelvey, Senior)
Administrative Patent Judge)


Richard E. Schafer)
Administrative Patent Judge)


Jameson Lee)
Administrative Patent Judge)


Sally C. Medley)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS
AND
INTERFERENCES.

Interference No. 104,192
Cragg v. Martin v. Fogarty

By Federal Express

Attorney for party Cragg:

Paul F. Prestia
RATHER & PRESTIA
Suite 301
One Westlakes (Berwyn)
P.O. Box 980
Valley Forge, Pennsylvania 19482-0980

Attorney for party Fogarty:

Bruce M. Collins
MATHEWS, COLLINS, SHEPHERD & GOULD, P.A.
100 Thanet Circle, Suite 306
Princeton, New Jersey 08540-3674

Attorney for party Martin:

Robert J. Koch
FULBRIGHT & JAWORSKI
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004



Merriam- Webster's Collegiate Dictionary

TENTH EDITION

Merriam-Webster, Incorporated
Springfield, Massachusetts, U.S.A.

Best Available Copy

not or practice of jobbing; a person having a regular job, in the practice of moving from job to job 2 : of or relating to collection of goods for sale as a business; inferior collection of items and uses; inferior collection of or items or depreciated white goods



JOCKEY

SUPPORTER

p. Sc. nickname
bo ride; or race 2 : a certified vehicle, a with the

(1700) 1 2 a : to urge, drive, or direct; to incite (~ a jockey in the)

promotion and regulation

crotch : *THREA CRURIS*
it + E *snap* (1889) : ATL

joke] (1673) 1 : gibe, taunt; humorous story or

what dim. of jocular] (1626)

and 2 : characterized by

trifly *W-KY-TAR-O-GL*

i. Ll. *locundus*, alter. of I

by or successive, of high

merit — *lo-cum-di-ty*

2 pl. of: riding breeches

in knee to ankle 2 : in

buckled at the side —

sh] (1640) : FELLOW, GUY

1 : the traditionally

warlike and apocalyptic

re — see *MILITARY*

1 (1813) : any of several

Eupatorium maculatum

symbiotic heads of type

a: baby animal; esp. a

r. of shog] (1548) 1

: to rouse to alertness

to go at a jog 4 : to

ig or shaking against a

or with a short

s hip — Thomas W.

: to go at a slow, leisurely

movement, pace, or

slow measured trot

ing or retreating part

of a jog 2 : a brief

(the road ~s to the

res 2 : a device for

ig [freq. of *jog*] n

y or jerkily — *jog-*

in a joining surface

2 : a dowel

2 : to join by means

course of action

John] (1861) : of

the New Testament

Haaniberg, village;

(as in California)

of the speeches made to Job by

various or depressed white men

white socks

2 : an Asian

c: Job's tears

2 : a quince

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**March 31, 2006 Memorandum Opinion
and Final Judgment
U.S. District Court, District of Columbia**

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

SCIMED LIFE SYSTEMS, INC.,)
Plaintiff and Counterclaim-Defendant,)
v.)
MEDTRONIC VASCULAR, INC.,)
Defendant and Counterclaim-Plaintiff,) Civil Case No. 01-2015 (RJL)
and)
ERIC C. MARTIN,)
Defendant and Counterclaim-Defendant.)

*S**
MEMORANDUM OPINION
(March 31, 2006) [# 76, 100, 102, 103]

Plaintiff, Scimed Life Systems, Inc. ("Scimed"), brought this action against defendants, Medtronic Vascular, Inc. ("Medtronic") and Eric C. Martin, under Title 35 of the United States Code Section 146, challenging the Final Decision and Judgment of the Board of Patent Appeals and Interferences (the "Board") of the United States Patent and Trademark Office ("USPTO") regarding Patent Interference No. 104,192 between certain patent applications for an apparatus for reinforcing a bifurcated lumen. Presently before the Court are Medtronic's Motion for Summary Judgment, Scimed's First and Second Motions for Summary Judgment, and Medtronic's Motion to Compel Production of Documents and

Things. After due consideration of the parties' submissions, the relevant law and the entire record herein, the Court finds that the Board did not erroneously affirm its Grant of the Fogarty *et al.* United States Patent Application Serial No. 08/463,836 (now owned by Medtronic) Motion 12 in its July 27, 2001 Final Decision and Judgment. Accordingly, this Court affirms the Board's Final Decision and Judgment and, therefore, GRANTS Medtronic's Motion for Summary Judgment, DENIES Scimed's First and Second Motions for Summary Judgment, and DENIES AS MOOT Medtronic's Motion to Compel Production of Documents and Things.

I. BACKGROUND

Plaintiff Scimed and defendant/counterclaimant Medtronic are each assignees of record of two different patent applications for a bifurcated lumen invention.¹ Andrew Cragg and Michael Dake (collectively referred to as party "Cragg" in the underlying proceedings at the USPTO) filed an application with the USPTO regarding the bifurcated lumen apparatus on June 5, 1995. The application was assigned the serial number 08/461,402 (the "'402 application"). Cragg and Dake assigned all rights in the '402 application to Boston Scientific Technology, Inc., which later merged into plaintiff Scimed. Scimed is now the present legal owner of the '402 application. Medtronic was assigned its rights in a patent application for the same invention by Thomas J. Fogarty, Timothy J. Ryan, and Kirsten Freislinger (collectively referred to as party "Fogarty" in the underlying proceedings at the

¹ The "Background" section of this Memorandum Opinion has been partially adapted from this Court's earlier Memorandum Opinion in *Scimed Life Systems, Inc. v. Medtronic Ave Inc.*, 297 F. Supp. 2d 4 (D.D.C. 2003).

USPTO). That application was also filed with the USPTO on June 5, 1995, and assigned the serial number 08/463,836 (the “‘836 application”). Party Fogarty assigned its rights in the ‘836 application to Medtronic Aneurx, Inc., which merged into Medtronic AVE, Inc. which later became the defendant/counterclaimant Medtronic. Medtronic is now the legal owner of the ‘836 application. Defendant/counterclaim-defendant Eric Martin owns patent No. 5,575,817 (the “Martin” or “‘817 patent”), based on application 08/293,541, filed on August 19, 2004.

On April 23, 1998, the USPTO Board declared an interference between Scimed's patent application (the “Cragg” or “‘402 application”), Medtronic's patent application (the “Fogarty” or “‘836 application”) and the Martin patent. This interference proceeding was assigned Interference No. 104,192, and is referred to as the “‘192 interference.”² On July 2, 1998, the Board set the following as the sole “count”³:

An apparatus for reinforcing a bifurcated lumen comprising:
a first section, configured to be positioned within the lumen, comprising:
an upper limb, configured to fit within the lumen upstream of the bifurcation;
a first lower limb, configured to extend into the first leg of said bifurcation
when said first section is positioned in the lumen, and

² “The purpose of an interference proceeding is to resolve the question of priority of invention when more than one applicant seeks a patent on substantially the same invention.” 3A-10 Donald S. Chisum, *Chisum on Patents* § 10.09[1][a] (2006). This action was brought in federal Court pursuant to 35 U.S.C. § 146, which allows a party dissatisfied with the decision of the Board in an interference to bring a civil action as long as the Board’s decision is not being appealed to the United States Court of Appeals for the Federal Circuit “and such appeal is pending or has been decided.” See 35 U.S.C. § 146.

³ “A count defines the interfering subject matter. In *In re Van Geuns* (1993), the Federal Circuit noted that (1) ‘[a]lthough claims of one or more of the parties may be identical to the count of an interference, the count is not a claim to an invention,’ and (2) ‘[t]he count of an interference is merely the vehicle for contesting the priority of invention and determining what evidence is relevant to the issue of priority.’” 3A-10 Donald S. Chisum, *Chisum on Patents* § 10.09[3] (2006).

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

Cragg et al. v. Martin v. Fogarty et al., Patent Interference No. 104,192, Paper No. 187, Final Decision and Judgment at 5-6 (United States Patent and Trademark Office, Board of Patent Appeals and Inferences July 21, 2001) (“Board’s Final Judgment”). The purpose of the ‘192 Interference was for the Board to determine who among the three parties had priority of inventorship, and was, therefore, entitled to the invention defined by the count.

At the time of declaration of the interference, party Cragg was accorded by the USPTO the benefit of the filing dates of two European patent applications (i.e. February 9 and June 10, 1994), which had been filed by a French Company known as Mintec SARL. At the time of declaration of the interference, party Fogarty, on the other hand, was accorded by the USPTO the benefit of the earlier filing date of U.S. patent application 08/255,681: i.e. on June 8, 1994. Thus, at the start of the interference, party Cragg was designated the “senior party,”⁴ on the basis of the accorded benefit date of February 9, 1994. On March 13, 2000, party Fogarty filed a preliminary motion attacking the benefit accorded party Cragg to

⁴ “In an interference proceeding, the first party to file is designated as the ‘senior party’ and all other parties as ‘junior.’ The junior party bears the burden of going forward with evidence as to actual reduction to practice prior to the senior party’s filing date or conception prior to the senior party’s filing date plus continuous and reasonable diligence during the critical period. If the senior party desires to show a date of conception or reduction to practice prior to his filing date, he bears the burden of going forward with evidence.” 3A-10 Donald S. Chisum, Chisum on Patents § 10.03[1][c][ii] (2006).

the filing dates of the two European applications and sought to be made the senior party in the interference. On April 7, 2000, the Board granted party Fogarty's preliminary motion 12, declaring party Fogarty the senior party in the interference and party Cragg and party Martin as junior parties in the interference. *Cragg et al. v. Martin v. Fogarty et al.*, Patent Interference No. 104,192, Paper No. 130, Decision on Party Cragg's Motion to Correct the Preliminary Statement and on Party Fogarty's Preliminary Motion No. 12 at 7 (United States Patent and Trademark Office, Board of Patent Appeals and Inferences April 24, 2000)(“Decision on Preliminary Motion No. 12”). In that same opinion, the Board denied party Cragg's motion to amend its preliminary statement to name Michael D. Dake and Andrew H. Cragg as co-inventors of the party Cragg invention. *Id.* at 7. Party Cragg requested reconsideration of that decision claiming that the Board had erred in its ruling and claimed that Mintec filed the European applications as assignees of both Dake and Cragg, the co-inventors of the subject matter of the patent application.

On April 24, 2000, the Board issued a Decision on Reconsideration denying the request for reconsideration on the basis that Dake's assignment of his rights in the patent application came after the filing of the European application and that 35 U.S.C. § 119 could not be interpreted to allow Mintec the benefit of priority with this subsequent assignment of rights. *Cragg et al. v. Martin v. Fogarty et al.*, Patent Interference No. 104,192, Paper No. 138, Decision on Reconsideration (United States Patent and Trademark Office, Board of Patent Appeals and Inferences April 24, 2000)(“Board’s Decision on Reconsideration”). In

its decision, the Board interpreted Title 35 of the United States Code Section 119 to require that “the previously filed foreign application must have been filed by the person or one who was, at the time of filing of the previously filed foreign application, already a legal representative or assign of that person.” *Id.* at 3. The Board went on to state that their interpretation of Section 119 “is necessary to ensure a link between the presently involved application and the earlier filed foreign application with respect to the particular inventor. A contrary interpretation would cause entitlement to benefit to be negotiable as a commodity between unrelated entities.” *Id.* In essence, the Board rejected party Cragg’s position on the assignment of rights to the patent and stated:

We are unpersuaded that an assignment of ownership rights changes on whose behalf an application was previously already filed. It would appear that only filings subsequent to the assignment of rights from Michael D. Dake can be deemed as being executed or performed on his behalf.

Id. at 5. Party Cragg requested a final hearing for review of the Board’s decision claiming that the Board had erroneously interpreted Section 119 and that Dake and Cragg were co-inventors and that Mintec SARL was the assignee of both Dake and Cragg for the subject matter invention even though the assignments occurred after the European patent applications were filed. *See id* at 11-23. On July 27, 2001, the Board issued its Final Decision and Judgment. *See* Board’s Final Judgment.

In its Final Judgment, the Board adopted its earlier interpretation of 35 U.S.C. § 119. *Id.* at 9. The Board cited *Vogel v. Jones*, 486 F.2d 1068, 1072 (C.C.P.A. 1973), for the proposition that “a foreign application made by the assignee of a U.S. applicant, on behalf

of one other than the United States inventor, is irrelevant to the rights of priority of the U.S. inventor." *Id.* at 10. The Board stated that the "plain statutory language" of Section 119 does not put "an assignee in the same position as if it were a 'legal representative' or 'assign' of the inventor at a previous time when a foreign application for the same invention was filed by that assignee." *Id.* at 12. The Board found that Dake assigned his invention to Mintec, Inc. more than two years *after* the filing of the two European patent applications. *Id.* at 11-12. The Board went on to state, that even assuming that party Cragg's preliminary statement identified both Cragg and Dake as co-inventors of the subject matter of the count, that fact would not help party Cragg as "Cragg also did not assign his rights to Mintec, Inc. until after" the two European patent applications were filed. *Id.* at 20. The Board found that "MINTEC SARL was not an assign of either Michael D. Dake nor Andrew H. Cragg when it filed European applications EP94400284.9 and EP94401306.9." *Id.* For those reasons, and others, the Board found that there was no error in the granting of party Fogarty's preliminary motion 12. *Id.* at 23.

On September 25, 2001, Scimed filed this appeal under Title 35 of the United States Code Section 146, seeking this Court's review of the Board's Final Decision and Judgment in the '192 Interference. The parties to this action entered into a stipulation and order limiting the issues in this case. The stipulated issue to be resolved is:

Whether the Board erroneously affirmed its Grant of Fogarty *et al.* (Medtronic) Motion 12 in its July 27, 2001 Final Decision denying Cragg *et al.* (Scimed) benefit of the February 9, 1994 filing date of its European application No.

94400284.9 as a date of invention for the subject matter of the single count in Interference No. 104,192.

(See Stipulation and Order entered March 25, 2004, Dkt. 50.) On July 22, 2005, both parties moved for summary judgment on this remaining issue and provided the Court with exhibits supporting their positions.

II. STANDARD OF REVIEW

Summary Judgment is appropriate when the pleadings and the record demonstrate that "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *see also Celotex v. Catrett*, 477 U.S. 317, 322 (1986); *Diamond v. Atwood*, 43 F.3d 1538, 1540 (D.C. Cir. 1995). To determine which facts are "material," a Court must look to the substantive law on which each claims rests. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A "genuine issue" is one whose resolution could establish an element of a claim or defense and, therefore, affect the outcome of the action. *Celotex*, 477 U.S. at 322; *Anderson*, 477 U.S. at 248. Additionally, to be a genuine issue of fact, it must be supported by sufficient admissible evidence such that a reasonable trier of fact could find for the nonmovant. *See Laningham v. United States Navy*, 813 F.2d 1236, 1242-43 (D.C. Cir. 1987).

The moving party bears the initial burden of "identifying those portions of the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrates the absence of a genuine issue of material fact." *See Celotex*, 477 U.S. at 323. In order to prevail on its motion for summary judgment,

the movant must show that the nonmovant "fail[ed] to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." *Id.* at 322.

In opposing summary judgment, the "nonmoving party [must] go beyond the pleadings and by [its] own affidavits, or by the depositions, answers to interrogatories, and 'admissions on file,' designate 'specific facts showing that there is a genuine issue for trial.'" *Id.* at 324. The Court must view the facts in the light most favorable to the nonmovant, giving the nonmovant the benefit of all justifiable inferences derived from the evidence in the record. *Anderson*, 477 U.S. at 255 (1986). The nonmovant, however, must establish more than "the mere existence of a scintilla of evidence" in support of its position. *Id.* at 252.

In order for Scimed to prevail on summary judgment, Scimed must put forth evidence and legal support that meets the standard of proof this Court is required to apply when reviewing decisions of the Board of Patent Appeals and Interferences of the USPTO. In determining whether or not the Board erroneously affirmed its Grant of party Fogarty's preliminary motion 12 and, therefore, erroneously awarded priority for the subject matter of the single count in the '192 Interference to Medtronic, this Court will apply the standard of proof set forth in *Morgan v. Daniels*, in that when a decision has been made by the Patent Office in an action contesting priority of invention, "the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries

thorough conviction." *Morgan*, 153 U.S. 120, 125 (1894) (emphasis added) (determining the standard of review for a Patent Office decision when no additional evidence was put forth to the Circuit Court). Our Circuit Court, in *United States v. Szuecs*, 240 F.2d 886 (D.C. Cir. 1957), upheld the *Morgan* standard of proof that must be applied by a District Court when reviewing a decision of the Patent Office pursuant to 35 U.S.C. § 146. "To reach a conclusion contrary to that of the Patent Office," the *Morgan* standard requires the evidence to carry "'thorough conviction.'" *Szuecs*, 240 F.2d at 887 (citing *Morgan*, 153 U.S. at 125) (reversing and remanding the case to the District Court to apply the correct standard of proof).

Another District Court Judge of this Court reaffirmed the application of *Morgan* in reviewing Patent Office cases under 35 U.S.C. § 146. *Anderson v. Anderson*, 403 F. Supp. 834, 844-45 (D.D.C. 1975) (affirming the decision of the Board of Patent Interferences after reviewing the full administrative record and hearing additional oral testimony), *aff'd*, 543 F.2d 1389 (D.C. Cir. Nov. 11, 1976). In *Anderson*, Judge John H. Pratt found that the "Patent Office is entitled to a presumption of correctness and regularity." *Id.* at 844 (citing *Vogel v. Jones*, 346 F. Supp. 1005 (D.D.C. 1972)). Judge Pratt went on to reiterate that the District Court could not overturn the Board's decision unless the evidence put forth by the movant carried "thorough conviction," and "[t]he 'thorough conviction' standard imposes a heavy burden on plaintiffs in an action under 35 U.S.C. § 146," and that "[a] mere preponderance of the evidence is not enough to justify reversing the Patent Office." *Id.* at

845. For the following reasons, the Court finds that the plaintiff has failed to meet its heavy burden, and concludes that the Board did not err in its interpretation of Section 119.

III. ANALYSIS

A. Interpretation of 35 U.S.C. § 119

In the Board's Final Judgment, it reaffirmed its earlier decision that the "plain statutory language" of Section 119 requires that the person who filed the foreign patent application must have been a legal representative or assign of the person who filed the patent application in the United States at the time that the foreign patent application was filed.⁵ Board's Final Judgment 9-10. The pertinent part of Section 119 reads:

- (a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country.

35 U.S.C. § 119(a). The Board's interpretation of Section 119 is supported by *Vogel v. Jones*, 486 F.2d 1068 (C.C.P.A. 1973). See Board's Final Decision 10-11. In *Vogel*, the Court of Customs and Patent Appeal, the predecessor to the current Court of Appeals for the Federal Circuit, read Section 119 to mean "that an applicant for a United States patent can rely for priority on the 'first filed' application by an assignee on his behalf." 486 F.2d at

⁵ While counsel for Scimed is quick to point out its own grammatical analysis of Section 119 without citing to any grammar reference guide, the Court notes that it is quite capable of reading the statute, interpreting the language of the statute, researching the case law pertaining to the statute and applying that law to the present action.

1072. In order for the foreign patent application to be filed on behalf of the United States applicant, the person filing the foreign application must be an assignee or legal representative *at the time* that the foreign application was filed. *Id.* If the foreign applicant was allowed to become the legal representative or assign of the United States applicant *after* the foreign application was filed, it would be impossible for the foreign application to have been filed *on the behalf* of the United States applicant. If the Board or this Court held otherwise, the right of priority could be, as the Board noted, traded or sold as a commodity to the highest bidder. *See* Board's Decision on Reconsideration 3; Board's Final Decision 9. Therefore, this Court does not find that the Board erred in its interpretation of Section 119 and Scimed has neither cited any precedent or legislative history that would warrant interpreting the statute otherwise.⁶

⁶ Scimed argues that the Board's construction of Section 119 is inconsistent with the Paris Convention for the Protection of Industrial Property, *opened for signature* Mar. 20, 1883, as amended at Stockholm, July 14, 1967, 21 U.S.T. 1630, 828 U.N.T.S. 305 ("Paris Convention"), and asks this Court to find that the Board's erroneously construed Section 119 as the Board's construction is inconsistent with and violates Article 4 of the Paris Convention. While Section 119, and its predecessor R.S. 4887, were enacted in order to implement Article 4 of the Paris Convention, *Vogel*, 486 F.2d at 1072, the Board's construction of Section 119, which this Court finds correct, does not violate and is not inconsistent with the Paris Convention. The Paris Convention is not self-executing and, therefore, the U.S. was free to implement the Paris Convention in the manner and form that Congress deemed appropriate. *In re Dr. Matthais Rath*, 402 F.3d 1207, 1209-10 (Fed. Cir. 2005). Congress executed Article 4 of the Paris Convention first with R.S. 4887, and then with Section 119, and Section 119 requires that in order to claim a right of priority in a foreign application, the foreign application must have been filed by the U.S. applicant or a person or entity who was a legal representative or assign of the U.S. applicant *at the time* that the foreign application was filed. The concern expressed by Scimed that upholding the Board's construction of Section 119 would have in foreign countries is conjecture and "based on pure speculation." *See Kawai v. Mettlestics*, 480 F.2d 880, 889 (C.C.P.A. 1973).

B. Review of Board's Decision

Having found that the Board did not err in its reading and interpretation of Section 119, the question remains whether the Board erred in granting Medtronic's preliminary motion 12 seeking to deny Scimed the benefit of the filing date of its European patent applications. It did not. While a review by this Court of a Board's Final Decision is a "hybrid of an appeal and a trial de novo" because the Court considers evidence before the Board "as well as evidence that was not before the Board," *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1345 (Fed. Cir. 2000) (quoting *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 592 (Fed. Cir. 1997)), it nonetheless must treat the Board's decision as controlling "unless the contrary is established by testimony which in character and amount carries thorough conviction." *Morgan*, 153 U.S. at 125.

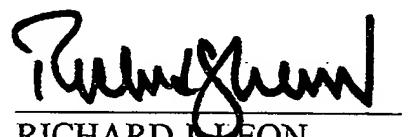
Scimed argues that the '284 European application was either filed on Dake's behalf "pursuant to the constructive trust imposed upon that application" when Mintec SARL filed the application, or a theory of an equitable assignment to party Cragg. (Scimed's Mem. of P&A in Opp'n to Medtronic's Mot. For Summ. J. 29, 35-36 ("Scimed's Opp'n"); Mem. of P&A in Supp. of Scimed's Second Mot. For Summ J. That Scimed is Entitled to the Priority of Its EP '284 Application Even Under the Board's Construction of 35 U.S.C. § 119(a)) 31-33 ("Scimed's Second Mot. For Summ. J.").) As this Court earlier recognized, "[t]he Federal Circuit in *Conservolite [Inc., v. Widmayer]* held that a party's failure to raise the issue in a preliminary motion not only precluded it not from raising the matter at the final hearing, but

also precluded district Court review.” *Scimed Life Systems, Inc. v. Medtronic AVE, Inc.*, 297 F. Supp. 2d 4, 8 (D.D.C. 2003) (citing *Conservolite, Inc. v. Widmayer*, 21 F.3d 1098, 1102 (Fed. Cir. 1994)). The Federal Circuit has stated that “[i]n order for an issue to have been raised adequately so that it qualifies for consideration in a § 146 proceeding, the issue should have been raised as specified in the PTO's interference rules, for example, through preliminary motions, motions to correct inventorship, miscellaneous motions, belated motions delayed for good cause, or oppositions to these motions.” *Conservolite*, 21 F.3d at 1102. Therefore, Scimed is precluded from arguing that the Board erred in denying priority to Scimed either under the newfound constructive trust or equitable assignment theories advanced before this Court.

Thus, applying the *Morgan* standard of proof to this review and not having conducted a *de novo* review as in *Winner*, the Court finds that Scimed has not presented sufficient evidence that Mintec SARL was either the legal representative or assign of Dake or Cragg at the time that the relevant European patent applications were filed. Accordingly, party Cragg and Scimed cannot claim the benefit of priority of the European patent applications. Therefore, this Court finds that the Board did not err in its granting of party Fogarty’s (Medtronic’s) motion No. 12 which denied Cragg *et al.* (Scimed) the benefit of the earlier filing date of European application No. 94400284.9 and affirms the Board’s award of priority to Fogarty *et al.* (Medtronic) in its July 27, 2001 Final Decision and Judgment.

IV. CONCLUSION

For the foregoing reasons, the Court GRANTS defendant and counterclaim-plaintiff Medtronic's Motion for Summary Judgment [#100]; DENIES Plaintiff and counterclaim-defendant Scimed's First Motion for Summary Judgment [#102]; DENIES Plaintiff and counterclaim-defendant Scimed's Second Motion for Summary Judgment [#103]; and DENIES AS MOOT defendant and counterclaim-plaintiff Medtronic's Motion to Compel Production of Documents and Things [#76]. An order consistent with this decision accompanies this Memorandum Opinion.



RICHARD J. LEON
United States District Judge

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

SCIMED LIFE SYSTEMS, INC.,)
Plaintiff and Counterclaim-Defendant ,)
v.)
MEDTRONIC VASCULAR, INC.,)
Defendant and Counterclaim-Plaintiff,) Civil Case No. 01-2015 (RJL)
and)
ERIC C. MARTIN,)
Defendant and Counterclaim-Defendant.)

FINAL JUDGMENT

For the reasons set forth in the Memorandum Opinion entered this date, it is, this
31st day of March 2006, hereby

ORDERED that defendant and counterclaim defendant Medtronic Vascular, Inc's ("Medtronic") Motion to Compel Motion to Compel Production of Documents and Things [#76] is **DENIED AS MOOT**; and it is further

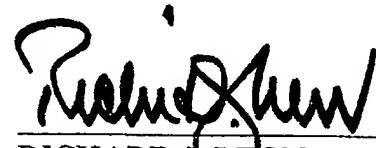
ORDERED that Medtronic's Motion for Summary Judgment [#100] is **GRANTED**; and it is further

ORDERED that Scimed Life Systems, Inc.'s ("Scimed") First Motion for Summary Judgment [#102] is **DENIED**; and it is further

ORDERED that Scimed Life Systems, Inc.'s ("Scimed") Second Motion for Summary Judgment [#103] is **DENIED**; and it is further

ORDERED that judgment is entered in favor of defendant and counterclaim defendant Medtronic, that the Board of Patent Appeals and Interferences Final Decision and Judgment issued on July 27, 2001, is affirmed, and that the case is dismissed with prejudice.

SO ORDERED.



RICHARD J. LEON
United States District Judge

**August 8, 2007 U.S. Court of Appeals For the
Federal Circuit Opinion**

United States Court of Appeals for the Federal Circuit

2006-1434

BOSTON SCIENTIFIC SCIMED, INC.
(formerly known as Scimed Life Systems, Inc.),

Plaintiff-Appellant,

v.

MEDTRONIC VASCULAR, Inc.
(also known as Medtronic AVE, Inc.),

Defendant-Appellee,

and

ERIC C. MARTIN,

Defendant.

Gregory A. Castanias, Jones Day, of Washington, DC, argued for the plaintiff-appellant. With him on the brief were Gidon D. Stern, Thomas E. Friebel, Catharina J. Chin Eng, and Brent P. Ray, of New York, New York.

Brian E. Ferguson, McDermott Will & Emery LLP, of Washington, DC, argued for the defendant-appellee. On the brief were Paul Devinsky, John R. Fuisz, Stephen K. Shahida, and Natalia V. Blinkova. Of counsel were Joel M. Freed and Amanda E. Koenig.

Appealed from: United States District Court for the District of Columbia

Judge Richard J. Leon

United States Court of Appeals for the Federal Circuit

2006-1434

BOSTON SCIENTIFIC SCIMED, INC. (formerly known as Scimed Life Systems, Inc.),

Plaintiff-Appellant,

v.

MEDTRONIC VASCULAR, Inc. (also known as Medtronic AVE, Inc.),

Defendant-Appellee,

and

ERIC C. MARTIN,

Defendant.

DECIDED: August 8, 2007

Before MAYER, BRYSON and PROST, Circuit Judges.

MAYER, Circuit Judge.

Boston Scientific Scimed, Inc. ("Scimed")* appeals the district court's grant of summary judgment affirming the Board of Patent Appeals and Interferences' final decision, which denied Scimed the priority benefit of an earlier-filed European patent application for the subject matter at issue in Patent Interference Number 104,192 ("the

* Plaintiff-appellant Boston Scientific Scimed, Inc., was formerly known as Scimed Life Systems, Inc., and will be referred to throughout this opinion as "Scimed."

'192 interference"). Scimed Life Sys., Inc. v. Medtronic Vascular, Inc., 486 F. Supp. 2d 60 (D.D.C. 2006). We affirm.

Background

This appeal stems from an interference proceeding before the United States Patent and Trademark Office Board of Patent Appeals and Interferences. Scimed and Medtronic Vascular, Inc. ("Medtronic") are each assignees of different United States patent applications covering the same invention. Andrew Cragg and Michael Dake (collectively "Cragg") filed patent application 08/461,402 ("the '402 application") for the invention in question on June 5, 1995. Cragg then assigned all rights in the '402 application to Boston Scientific Technology, Inc., which later merged into Scimed, the plaintiff-appellant and current legal owner of the '402 application. Also on June 5, 1995, Thomas J. Fogarty, Timothy J. Ryan, and Kirsten Freislinger (collectively "Fogarty") filed patent application 08/463,836 ("the '836 application") for the same invention. Fogarty assigned their rights in the '836 application to a company that eventually became Medtronic, the defendant-appellee and current legal owner of the '836 application. Eric Martin, a third-party to the instant appeal, owns U.S. Patent No. 5,575,817 (the "Martin patent" or "817 patent"), which resulted from an application filed on August 19, 1994.

On April 23, 1998, the board declared an interference between Scimed's '402 application, Medtronic's '836 application, and Martin's '817 patent. The purpose of the interference was to determine which party had priority of inventorship, thereby entitling it to the invention as set forth in the sole count of the interference:

An apparatus for reinforcing a bifurcated lumen comprising:
a first section, configured to be positioned within the lumen,
comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into the first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

Cragg v. Martin v. Fogarty, Patent Interference No. 104,192, Paper No. 187, 2001 WL 1339890 at *2-3 (B.P.A.I. July 21, 2001) ("Final Interference Decision").

The board initially gave Cragg the benefit of the filing dates of two European patent applications filed by MinTec SARL ("MinTec"), a French company. The earlier of these dates was February 9, 1994. At the time these European applications were filed, no legal relationship existed between MinTec and Cragg, nor was MinTec acting on behalf of Cragg. Fogerty was granted the benefit of the filing date of U.S. patent application 08/255,681, which was June 8, 1994. Martin was accorded benefit of the application that led to the '817 patent, which was filed on August 19, 1994. Accordingly, the PTO initially designated Cragg as the senior party in the interference.

Fogarty responded by filing a motion attacking the priority benefit granted to Cragg. The board granted the motion, declaring Fogarty the senior party in the interference. After Cragg protested this decision, the board issued a final decision denying his request to be declared the senior party. The board ruled that Cragg was not entitled to priority benefit under 35 U.S.C. § 119 because neither Cragg nor Dake had assigned their rights to MinTec until after it had filed the European applications.

Final Interference Decision, 2001 WL 1339890, at *5.

Scimed, the assignee of Cragg's U.S. patent application, then brought an action in the United States District Court for the District of Columbia challenging the board's final decision in the '192 interference. The district court affirmed the board's final decision, Scimed, 486 F. Supp. 2d at 61, and Scimed filed this appeal. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

Discussion

We review a district court's grant of summary judgment de novo. Monsanto Co. v. Scruggs, 459 F.3d 1328, 1344 (Fed. Cir. 2006). We also apply a de novo standard when reviewing questions of law, including a trial court's interpretation of statutory language. Pitsker v. Office of Pers. Mgmt., 234 F.3d 1378, 1381 (Fed. Cir. 2000).

At issue here is whether 35 U.S.C. § 119(a)** permits an applicant for a United States patent to benefit from the priority of a foreign application previously filed by an entity that was not acting on behalf of the U.S. applicant at the time of filing. We hold that it does not.

A similar issue was addressed by the Court of Customs and Patent Appeals in Vogel v. Jones, 486 F.2d 1068 (CCPA 1973), which, to the extent relevant here, is binding upon us, South Corp. v. United States, 690 F.2d 1368, 1370 (Fed. Cir. 1982)

** 35 U.S.C. § 119(a) reads in relevant part:

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed

(en banc). According to Vogel, “§ 119 gives rise to a right of priority that is personal to the United States applicant.” 486 F.2d at 1072. Due to the personal nature of this right, an applicant for a U.S. patent may only benefit from the priority of a foreign application if it was filed by the U.S. applicant or “on his behalf.” Id.

Scimed argues that Vogel does not require the foreign applicant to have been acting on behalf of the U.S. applicant at the time the foreign application was filed. It points to the following passage in support:

This practice [of allowing a U.S. applicant to claim priority from a foreign application filed by someone else] arose because it was recognized that in many foreign countries, unlike in the United States, the actual applicant for a patent can be other than the inventor, e.g., an assignee. In light of this, we regard the language in § 119 referring to legal representatives and assigns to merely represent a codification of the actual practice under [the predecessor statute to § 119]. Since under United States law an application for patent must be made by the inventor, that practice was based on the requirement that the foreign application, regardless of the identity of the applicant, must have been filed for an invention actually made by the inventive entity seeking to rely upon it for priority purposes. We think § 119 must be construed to the same end.

Id. (footnote omitted). Scimed attempts to construe this language as permitting a U.S. applicant to benefit from a foreign application’s earlier filing date whenever “the invention described in the foreign application [is the same] one actually made by the U.S. applicant,” “regardless of the identity of the applicant” of the foreign application.” According to its interpretation, “the Vogel court did not hold that the foreign application must have been filed by a person who was an assignee or legal representative of the U.S. inventor at the time the foreign application was filed, or that the foreign application must have been filed on his behalf in order for there to be priority benefit.” We disagree.

Vogel clearly held that the above-quoted passage “means that an applicant for a United States patent can rely for priority on the ‘first filed’ application by an assignee on his behalf.” Id. (emphasis added). Moreover, “the existence of an application made by [the inventor’s] assignee in a foreign country on behalf of one other than the United States inventor is irrelevant to his right of priority based on applications made on his behalf.” Id. In other words, while the foreign application must obviously be for the same invention and may be filed by someone other than the inventor, section 119(a) also requires that a nexus exist between the inventor and the foreign applicant at the time the foreign application was filed. Indeed, as a matter of pure logic, an entity could not have filed a foreign application “on behalf of” an inventor without the inventor’s knowledge or consent; that the foreign application may have been filed in accordance with the laws of the country in which it was filed has no bearing here. Therefore, to the extent that there may have been any uncertainty or ambiguity in Vogel, we now explicitly hold that a foreign application may only form the basis for priority under section 119(a) if that application was filed by either the U.S. applicant himself, or by someone acting on his behalf at the time the foreign application was filed.

Scimed also contends that the district court erred by precluding it from presenting evidence relating to theories of constructive trust and equitable assignment. A party may present new evidence to the trial court when appealing a board decision in an interference proceeding. Conservolite, Inc. v. Widmayer, 21 F.3d 1098, 1102 (Fed. Cir. 1994). A party may not, however, advance new legal theories at the trial court level, even if the overarching legal issue was presented below. See id. (“[A]n action under [35 U.S.C.] § 146 is essentially a proceeding to review the action of the Board. . . . [T]he

parties to an interference must make a complete presentation of the issues at the Board level so that the interference is efficient and not wasteful of administrative and judicial resources.”). Failure to advance legal theories before the board constitutes a failure to “make a complete presentation of the issues,” and permitting a party to raise those theories for the first time before the trial court would be both inefficient and “wasteful of administrative and judicial resources.” The parties stipulated that the only issue to be resolved by the district court was whether the board correctly ruled on Fogarty’s motion attacking the priority benefit initially granted to Cragg, Scimed, 486 F. Supp. 2d at 64, and Scimed did not raise either of these theories before the board, see Final Interference Decision, 2001 WL 1339890, at *3-10. The district court therefore did not err by precluding Scimed from presenting evidence to support these new legal theories.

Conclusion

Accordingly, the judgment of the United States District Court for the District of Columbia is affirmed.

AFFIRMED

**Paper No. 16
Motion To Correct Inventorship
Interference No. 104,083**

Paper No. _____
Attorney Docket No. BSI-944

Filed on behalf of: **PARTY GOICOECHEA ET AL.**

Filed by: Paul F. Prestia

Joshua L. Cohen
Ratner & Prestia
Suite 301, One Westlakes (Berwyn)
P.O. Box 980
Valley Forge, PA 19482-0980
Telephone: (610) 407-0700
Facsimile: (610) 407-0701

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Administrative Patent Judge Muriel E. Crawford

ERIC C. MARTIN
Junior Party,

v.

GEORGE GOICOECHEA, JOHN HUDSON, CLAUDE MIALHE,
ANDREW H. CRAGG and MICHAEL D. DAKE
Senior Party.

Patent Interference No. 104,083

GOICOECHEA ET AL. MOTION TO CORRECT INVENTORSHIP

Pursuant to 37 C.F.R. § 1.634, Party Goicoechea *et al.* moves, in
accordance with 37 C.F.R. § 1.48(b), for the grant of the Petition and entry

of the Amendment attached and for consent, as required under 37 C.F.R. § 1.615(a), to amend Application Serial No. 08/461,402 to correct inventorship by deletion of George Goicoechea, John Hudson, and Claude Mialhe.

Exhibit 1 (Petition to Correct Inventorship Pursuant to 37 C.F.R. § 1.48(b)), Exhibit 2 (Amendment of Inventorship Pursuant to 37 C.F.R. § 1.48(b)), Exhibit 3 (Claims Pending in Application 08,461,402 as of January 22, 1997), and Exhibit 4 (Claims Pending in Application as of August 14, 1998) are filed and served herewith.

In support of this Motion and the accompanying Petition, reference is made to portions of the application file for Application Serial No. 08/461,402, involved in this Interference.

(1) George Goicoechea, John Hudson, and Claude Mialhe,

were originally named as inventors in Application Serial No. 08/461,402, as indicated on the "Request for Filing a Patent Application under 37 CFR 1.60," filed on June 5, 1995.

(2) Application Serial No. 08/461,402 was filed with claims 1-53. Claims 2-53 were cancelled in the "Request for Filing a Patent Application under 37 CFR 1.60," filed on June 5, 1995; and a Preliminary Amendment filed on June 5, 1995 added new Claims 54-61.

(3) In responding to a Restriction Requirement on June 20, 1996, Applicants canceled claims 1, 54, 57, 58, 60 and 61, amended claims 55 and 56, and added new claims 62 to 87. Thus, claims 55 (amended), 56 (amended), 59 and 62-87 (copy attached as Exhibit 3 hereto) were pending in this application when an "Amendment of Inventorship Pursuant to 37 C.F.R. § 1.48(a)" and "Petition for Correction of Inventorship Pursuant to 37 C.F.R. § 1.48(a)," were filed on January 22, 1997.

(4) Upon grant of this Petition and entry of this Amendment, Andrew H. Cragg and Michael D. Dake were added as co-inventors of the subject matter then claimed.¹

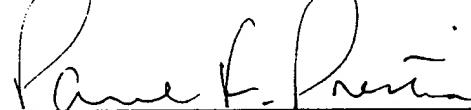
(5) Thereafter, as of May 22, 1997 this application was further amended, canceling claims 56 and 66-87, amending claims 55, 59 and 63, and adding claims 88-90. Upon entry of this amendment, the claims then and now pending in this application are claims 55, 59, 62, 63, 64, 65, 88, 89 and 90, a copy of which is attached as Exhibit 4 hereto.

¹ The Official Communication by which Applicants received notification of the grant of this Petition is missing from the file of Applicants' undersigned attorney. Applicants' undersigned attorney recalls that such a communication was received. This is corroborated by the Declaration of the present interference, in which the named inventorship entity includes Andrew H. Cragg and Michael D. Dake.

- (6) An error in the inventorship in Application Serial No. 08/461,402 was discovered on or about August 5, 1998, during a review of the subject matter of the claims then pending in the application; it was revealed during this review that the inventorship, as corrected in the Amendment and Petition filed on January 22, 1997, now should be changed again. More specifically, because of the cancellation of claims in the Amendment of May 22, 1997, previously named inventors Goicoechea, Mialhe and Hudson should not be named as inventors of the invention now claimed in Application Serial No. 08/461,402. Applicants' undersigned attorney believes that Michael D. Dake and Andrew H. Cragg alone are the true inventors of the subject matter now claimed in this application.
- (7) Upon discovery of this error, preparation of this Motion and the accompanying "Amendment of Inventorship Pursuant to § 1.48(b)" and "Petition for Correction of Inventorship Pursuant to 37 C.F.R. § 1.48(b)" was initiated.

In view of the foregoing, and pursuant to 37 C.F.R. § 1.634 and 37 C.F.R. § 1.48(b), consent to amend Application Serial No. 08/461,402 as required under 37 C.F.R. § 1.615(b) to correct inventorship by deletion of George Goicoechea, John Hudson, and Claude Mialhe and grant of the accompanying Petition to amend is respectfully requested.

Respectfully Submitted,



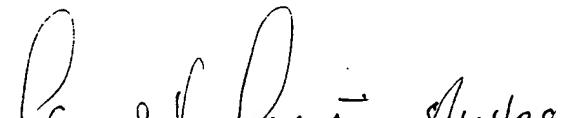
Paul F. Prestia, Reg. No. 23,031
Joshua L. Cohen, Reg. No. 38,040
Attorneys for Goicoechea et al.

Enclosures: Exhibit 1 (Petition to Correct Inventorship Pursuant to 37 C.F.R. § 1.48(b)); Exhibit 2 (Amendment of Inventorship Pursuant to 37 C.F.R. § 1.48(b)); Exhibit 3 (Claims Pending in Application 08/461,402 as of January 22, 1997); Exhibit 4 (Claims Pending in Application as of August 14, 1998)

CERTIFICATE OF MAILING AND SERVICE

I hereby certify that the foregoing document(s) is (are) being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "BOX INTERFERENCE, Commissioner of Patents and Trademarks, Washington, D.C. 20231," on the date indicated below, and that a copy thereof is being served by Express Mail to the Party Martin at the following address of record on the date indicated below.

Robert J. Koch, Esq.
Fulbright and Jaworski
801 Pennsylvania Ave. N.W.
Washington, DC 20004
Telephone: (202) 662-4765
Facsimile: (202) 662-4643


8/14/98

Paul F. Prestia
Joshua L. Cohen

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	G. Goicoechea et al.	: Art Unit:	3308
Serial No.:	08/461,402	: Examiner:	M. Milano
Filed:	June 5, 1995	:	
For:	BIFURCATED ENDOLUMINAL PROSTHESIS	:	

**PETITION FOR CORRECTION OF INVENTORSHIP PURSUANT
TO 37 C.F.R. § 1.48(b)**

Assistant Commissioner for Patents
Washington, D.C. 20231

SIR:

Applicants, by their attorney, request that the inventorship of the above-identified application be changed from George Goicoechea, Claude Mialhe, John Hudson, Andrew H. Cragg, and Michael D. Dake, to Michael D. Dake and Andrew H. Cragg. This Petition under 37 C.F.R. § 1.48(b) is to delete George Goicoechea, Claude Mialhe, and John Hudson as named inventors and to acknowledge that the invention of George Goicoechea, Claude Mialhe, and John Hudson is no longer being claimed in this Application.

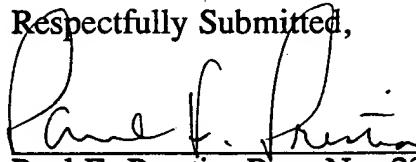
Filed herewith is an Amendment in Application 08/461,402 to effectuate this change. This Petition is also filed with a Motion to Correct Inventorship under 37 C.F.R. § 1.634 in Interference No. 104,083. The facts necessitating

this Petition and explicating why it should be granted are fully set forth in that Motion. That Statement of facts is incorporated herein by reference.

Pursuant to 37 C.F.R. § 1.17(i), a check is enclosed for the petition fee of \$130.00.

Entry into the application file of the Amendment of Inventorship Pursuant to 37 C.F.R. § 1.48(b), filed herewith, is respectfully requested.

Respectfully Submitted,



Paul F. Prestia, Reg. No. 23,031
Joshua L. Cohen, Reg. No. 38,040
Attorneys for Applicants

JLC\mjc

Dated: August 14, 1998

Suite 301
One Westlakes, Berwyn
P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Assistant Commissioner for Patents is hereby authorized
to charge payment to Deposit Account No. 18-0350 of any
fees associated with this communication.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	G. Goicoechea et al.	:	Art Unit:	3308
Serial No.:	08/461,402	:	Examiner:	M. Milano
Filed:	June 5, 1995	:		
For:	BIFURCATED ENDOLUMINAL PROSTHESIS	:		

**AMENDMENT OF INVENTORSHIP PURSUANT TO
37 C.F.R. § 1.48(b)**

Assistant Commissioner for Patents
Washington, D.C. 20231

SIR:

Please amend the designation of the inventorship entity in this Application by deleting the following inventors:

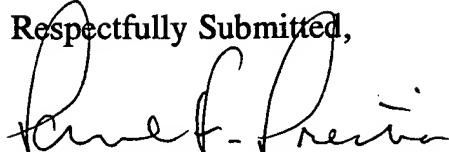
--George Goicoechea, Claude Mialhe, and John Hudson--.

REMARKS

This Application is currently involved in Interference No. 104,083. A Petition for Correction of Inventorship Pursuant to 37 C.F.R. 1.48(b) is filed herewith in support of this Amendment. This Amendment is an Exhibit to a motion ("Goicoechea *et al.* Motion to Correct Inventorship") filed herewith in the Interference in support of this Amendment.

Entry of this Amendment into the official file of this Application is respectfully requested.

Respectfully Submitted,



Paul F. Prestia, Reg. No. 23,031
Joshua L. Cohen, Reg. No. 38,040
Attorneys for Applicants

JLC\mjc

Dated: August 14, 1998

Suite 301
One Westlakes, Berwyn
P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Assistant Commissioner of Patents is hereby authorized
to charge payment to Deposit Account No. 18-0350 of any
fees associated with this communication.

**Claims Pending in U.S. Patent Application No. 08/461,402,
filed June 5, 1995, as of January 22, 1997**

55. A method of treating an angiographical disease at a bifurcation site where a blood vessel branches into a first branched vessel and a second branched vessel using a bifurcated stent having a bifurcation, a proximal portion, a first distal portion, and an extension portion extending distally relative to said bifurcation, and using a second stent, said method comprising the steps of:

- (a) disposing said proximal portion of said bifurcated stent in said blood vessel such that said first distal portion of said bifurcated stent extends into said first branched vessel;
- (b) directing blood flow from said blood vessel into said first branched vessel through said first distal portion of said bifurcated stent;
- (c) attaching said second stent to said extension portion of said bifurcated stent such that said second stent extends into said second branched vessel; and
- (d) directing blood flow from said blood vessel into said second branched vessel through said second distal portion of said bifurcated stent.

56. An endoluminal stent comprising a plurality of hoops which are axially displaced in a tubular configuration along a common axis, each of said hoops

- (a) being formed by a substantially complete turn of a sinuous configuration having apices, and
- (b) having a circumference that lies in a plane substantially perpendicular to the longitudinal axis of said stent;

wherein apices of adjacent hoops are juxtaposed to one another, and at least two juxtaposed apices are connected by a securing means.

59. A bifurcated stent for use in juxtaposition with an angiographical bifurcation of a blood vessel into two branched vessels comprising a proximal stent portion adapted to be disposed within said blood vessel in juxtaposition with said bifurcation, a distal stent portion adapted to extend across the bifurcation into one of the branched vessels, and a distal stent segment joined to said proximal portion and adapted to allow blood to flow from the proximal portion into the other branched vessel.

62. A method as claimed in claim 55 wherein said disease is stenosis.

63. A method as claimed in claim 55 further comprising the step of:

(d) covering at least said proximal portion, said first distal portion, and said second distal portion with a graft layer.

64. A method as claimed in claim 63 wherein said disease is an aneurysm.

65. A method as claimed in claim 63 wherein said disease is thrombosis.

66. An endoluminal stent as claimed in claim 56 in combination with one or more additional stent segments.

67. An endoluminal stent as claimed in claim 66 wherein at least one of said additional stent segments comprises a plurality of hoops which are axially displaced in a tubular configuration along a common axis, each of said hoops

(a) being formed by a substantially complete turn of a sinuous configuration having apices, and

(b) having a circumference that lies in a plane substantially perpendicular to the longitudinal axis of said stent;

wherein apices of adjacent hoops are juxtaposed to one another, and at least two juxtaposed apices are connected by a securing means.

68. An endoluminal stent as claimed in claim 66 wherein said one or more additional segments are axially aligned with one another.

69. An endoluminal stent as claimed in claim 66 wherein one or more additional segments are secured to one another by connecting means.

70. An endoluminal stent as claimed in claim 66 wherein adjacent hoops are of the same diameter.

71. An endoluminal stent as claimed in claim 66 wherein adjacent hoops are of a different diameter.

72. An endoluminal stent as claimed in claim 68 wherein axially aligned segments are connected to one another by a tubular fabric element.

73. An endoluminal stent as claimed in claim 66 wherein a first additional segment is axially parallel to, but non-common co-axial with, said stent.

74. An endoluminal stent as claimed in claim 73 further comprising a second additional segment axially parallel to said stent, but non-co-axial with either said stent or said first additional stent segment.

75. An endoluminal stent as claimed in claim 74 wherein at least one of said additional stent segments is of frustoconical shape and is further combined with an additional stent segment, one end of which includes a mating frustoconical shape.

76. An endoluminal stent as claimed in claim 75 wherein said mating frustoconical stent segments are adapted to be separately placed in a bifurcated artery and then, by expansion of one of said frustoconical stent segments, secured to one another.

77. An endoluminal stent as claimed in claim 56 wherein said hoops are formed of a single continuous wire.

78. An endoluminal stent as claimed in claim 56 wherein said securing means is a suture.

79. An endoluminal stent as claimed in claim 78 wherein said suture is a tied loop of thermoplastic material.

80. An endoluminal stent as claimed in claim 56 wherein said securing means is a ring.

81. An endoluminal stent as claimed in claim 56 wherein said securing means is a staple.

82. An endoluminal stent as claimed in claim 56 wherein said securing means is wire twisted into loop.

83. An endoluminal stent as claimed in claim 82 wherein said wire is nitinol.

84. An endoluminal stent as claimed in claim 56 wherein said securing means is bead of thermoplastic material.

84. An endoluminal stent as claimed in claim 56 wherein the plane of the circumference at each longitudinal end of the stent is square to the longitudinal axis of the stent.

86. An endoluminal stent as claimed in claim 56 wherein said stent is at least partially covered in fabric.

87. An endoluminal stent as claimed in claim 77 wherein said wire is nitinol.

PATENT

**Claims pending in U.S. Application No. 08/461,402, filed June 5, 1995, as of
August 14, 1998**

55. A method of treating an angeological disease at a bifurcation site where a blood vessel branches into a first branched vessel and a second branched vessel using a bifurcation prosthesis having a bifurcation, a proximal portion, a first distal portion, and an extension portion extending distally relative to said bifurcation, and using a second prosthesis, said method comprising the steps of:

(a) disposing said proximal portion of said bifurcated prosthesis in said blood vessel such that said first distal portion of said bifurcated prosthesis extends into said first branched vessel;

(b) directing blood flow from said blood vessel into said first branched vessel through said first distal portion of said bifurcated prosthesis;

(c) attaching said second prosthesis to said extension portion of said bifurcated prosthesis such that said second prosthesis extends into said second branched vessel; and

(d) directing blood flow from said blood vessel into said second branched vessel through said second prosthesis.

59. A bifurcated prosthesis for use with an angeological bifurcation of a blood vessel into two branched vessels comprising a bifurcated proximal portion adapted to be disposed within said blood vessel, a distal portion adapted to extend across the bifurcation into one of the branched vessels, and a separate distal segment joined to said proximal portion and adapted to allow blood to flow from the proximal portion into the other branched vessel.

62. A method as claimed in claim 55 wherein said disease is stenosis.

63. A method as claimed in claim 55 further comprising the step of:

(d) covering at least a portion of said proximal portion, said first distal portion, and said second prosthesis with a graft layer.

64. A method as claimed in claim 63 wherein said disease is an aneurysm.

65. A method as claimed in claim 63 wherein said disease is thrombosis.

88. The bifurcated prosthesis of claim 59 wherein said proximal portion, distal portion, and distal segment each comprise a stent and graft combination.

89. An apparatus for reinforcing a bifurcated lumen comprising:
a first section, configured to be positioned within the lumen,
comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation.

90. The apparatus of claim 89, further comprising a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

Paper No. 20
Decision on Motions
Interference No. 104,083

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

Filed by: Judge Jameson Lee
Trial Section
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

JAN 11 1999

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

ERIC C. MARTIN,

JAN 7 - 1999

Junior Party
(Patent No. 5,575,817),

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

GEORGE GOICOECHEA, JOHN HUDSON,
CLAUDE MIALHE, ANDREW H. CRAGG, and
MICHAEL D. DAKE

Senior Party
(Application 08/461,402)

Patent Interference No. 104,083

Before Lee, Administrative Patent Judge.

Decision on Motions

This interference has been reassigned to Judge Jameson Lee.

Senior party Goicoechea has filed a preliminary motion for benefit, under 37 CFR § 1.633(f), of the earlier filing date of application 08/312,881, which motion is unopposed by junior party Martin. Upon review of Goicoechea's submissions, it is

ORDERED that Goicoechea's motion for benefit is granted and

the senior party is further accorded the earlier filing date of application 08/312,881, i.e., September 27, 1994.

Senior party Goicoechea has also filed (1) a request to have an earlier filed petition to correct inventorship (January 24, 1997) considered, and (2) a further motion under 37 CFR § 1.634 to correct inventorship.

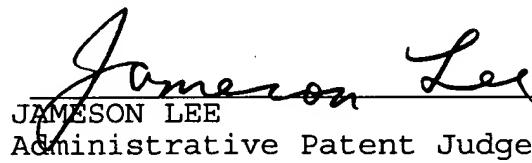
It is **ORDERED** that the request to have the petition of January 24, 1997, considered or acted on is dismissed. That petition was already granted by examiner Milano. In the margin of the Amendment accompanying that petition, examiner Milano had written the word "approved" and his initials. The APJ confirmed that fact in a telephone call to examiner Milano on January 6, 1999. The front of the file of Goicoechea's involved application already lists five joint-inventors on a label placed over the section for named inventors.

It is **FURTHER ORDERED** that the motion to correct inventorship, accompanied by a petition under 37 CFR § 1.48(b) and a corresponding amendment is granted. The petition satisfies all requirements of 37 CFR § 1.48(b) and party Martin has not articulated any reasonable basis for not granting the motion or petition. Martin's opposition to the motion was belated and states only that the motion should be deferred so that Martin can cross-examine Goicoechea's declarants. However, Goicoechea's motion to correct inventorship does not rely on any declaration.

Interference No. 104,083
Martin v. Goicoechea

Martin also has furnished no reasonable basis for obtaining additional testimony in connection with Goicoechea's motion to correct inventorship. See 37 CFR § 1.639(c).

It is **FURTHER ORDERED** that the parties shall serve the preliminary statement to each other within seven (7) days of the date of this communication.



JAMESON LEE
Administrative Patent Judge

Date: 11/7/99
Arlington, VA

Interference No. 104,083
Martin v. Goicoechea

Paul F. Prestia
Ratner & Prestia
Suite 301
One Westlakes (Berwyn)
P.O. Box 980
Valley Forge, Pennsylvania 19482-0980

Robert J. Koch
Fulbright & Jaworski
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004